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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1930.

No. 51.

SARANAC AUTOMATIC MACHINE CORPORATION,
Petitioner,

vs.

WIREBOUNDS PATENTS COMPANY, and 4-ONE BOX MACHINE MAKERS,
Respondents.

BRIEF FOR PETITIONER.

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May It Please the Court:

This case comes before your Honors, upon writ of certiorari issued to the Court of Appeals for the Sixth Circuit, based on conflicting decisions of that Court and the Court of Appeals for the Seventh Circuit as to the validity and infringement of claim 25 of patent No. 1,128,145, granted February 9, 1915, to Inwood and Lavenberg, for Means for Making Box Blanks.

Opinions Below.

The decree of the District Court for the Northern District of Illinois, Eastern Division, dismissing the bill of complaint for want of equity, was given without an opinion. The decree is found in Wirebounds *vs.* Gibbons record, Exhibit 17, at page 782.

The opinion of the Circuit Court of Appeals for the Seventh Circuit, affirming the decree of the District Court, is found in 25 Fed. (2d) 363.

The opinion of the District Court for the Western District of Michigan, Southern Division, holding the patent not infringed, is found in 24 Fed. (2d) 872.

The opinion of the Circuit Court of Appeals for the Sixth Circuit, reversing the decree of the District Court, and holding claim 25 of the patent valid and infringed, is found in 37 Fed. (2d) 830.

Copies of these opinions are printed in the Appendix to our Petition for Writ of Certiorari, pages 13-43 and 48-54.

Jurisdiction.

The present suit is before this Court on writ of certiorari under Section 347 of the Judicial Code and Rule 38 of the Supreme Court of the United States (par. 5, Sec. b), for a review of the decree of the United States Circuit Court of Appeals for the Sixth Circuit, the date of which decree is January 24, 1930 (R. 1783).

Petition for a writ of certiorari to the Sixth Circuit Court of Appeals was made by petitioner on February 20, 1930 (R. 1809), and the petition was granted by this Court on April 21, 1930 (R. 1809).

Statement of the Case.

On or about April 21, 1922, respondents herein, Wirebounds Patents Company and 4-One Box Machine Makers, brought a suit in the United States District Court at Chicago against one of petitioner's licensees, H. R. Gibbons Box Company, on four Inwood and Lavenberg patents, Nos. 12,725 (Reissue), 1,128,144, 1,128,145 and 1,128,252. On May 16, 1922, the United States District Court at Chicago (Judge Page) granted a preliminary injunction on said reissue box patent No. 12,725. Thereafter, on or about April 11, 1925, pursuant to final hearing in said Gibbons suit, the District Court (Judge Anderson) dismissed said Gibbons suit for want of equity. Repondents thereupon appealed to the Court of Appeals for the Seventh Circuit, and on February 6, 1928, that Court (Judges Alschuler, Evans, and Lindley) sustained the court below, except as to said box patent No. 12,725, which had expired before the decree. A rehearing in said Gibbons suit was denied on May 2, 1928, and a second application for rehearing was denied July 6, 1928.

While said Gibbons suit was pending in the District Court at Chicago, respondents started the instant suit at Grand Rapids, Michigan, against Saranac Automatic Machine Corporation, the petitioner herein, which corporation had manufactured and leased the machines complained of in the said Gibbons suit and had manufactured and leased, elsewhere, other machines of like character. The suit at Grand Rapids was commenced after the box patent No. 12,725 had expired, and this suit, therefore, was based upon the same three patents which had been held invalid in the Gibbons suit in Chicago, patents Nos. 1,128,144, 1,128,145 and 1,128,252. The District Court at Grand Rapids (Judge Raymond) on July 9, 1927, dismissed the bill of complaint for want of equity. The opinion held the method patent

No. 1,128,252 invalid, and that all three of the patents in suit were not infringed (24 Fed. (2d) 872).

Respondents then appealed to the Court of Appeals for the Sixth Circuit, which Court (Judges Denison and Mack, Judge Knappen dissenting), on January 25, 1930, rendered its opinion finding claim 25 of the machine patent No. 1,128,145 valid and infringed, and dismissing the bill, without prejudice, as to the other two patents (37 Fed. (2d) 830). This opinion as to claim 25 of the machine patent is in direct conflict with the previous decree of the Circuit Court of Appeals for the Seventh Circuit, which had held said claim invalid (25 Fed. (2d) 363). In both circuits the patent sued upon was the same; in both circuits the alleged infringement was the product of the same manufacturer, the petitioner herein.

Thus, in the present litigation, five Federal Judges have held the patent now before this Court invalid. One other Judge has held the claim in issue not infringed by petitioner's construction, while two Judges have held this claim valid and infringed. In previous litigation over the title of certain patents, including the patent here involved, but which litigation necessitated inquiry into the scope of the patents, the Circuit Court of Appeals for the Seventh Circuit, in 1911 (Judges Grosscup, Baker and Seaman), specifically held that said patents, including the patent here in suit, were mere improvement patents. In that suit, *National Wirebound Box Co.* v. *Healy*, the Court said:

> "The patents and applications involved in this suit are mere improvements upon, and extensions of, this art." (189 Fed. 49, 51.)

The defenses in the instant suit are: Invalidity and non-infringement of claim 25 of patent 1,128,145. The defenses are based upon several grounds which will be detailed in the body of the brief.

Specification of Assigned Errors.

The Court of Appeals for the Sixth Circuit erred:

1. In holding claim 25 of patent No. 1,128,145 valid.

2. In holding that petitioner has infringed claim 25 of patent No. 1,128,145.

3. In not holding that after the public acquired the right to follow the teachings of the Inwood and Lavenberg box patent, No. 12,725, petitioner had the right to make that blank upon the prior art Rosback machine, adding such number of pushers to the feed chains as were called for by the number of cleats in the blank.

4. In not holding that all that petitioner has done, regardless of whether the patent in suit is valid or invalid, is to make the blank of the expired box patent, Reissue No. 12,725, by the use of the prior art Rosback machine, with additional pushers placed on the feed chains, and that the same involved no invention (none covered by the patent in suit) over the teachings of the expired box patent and the prior art Rosback patents.

5. In holding that there was infringement of the patent in suit in adding the necessary pushers to the prior art Rosback machine to produce the box blank shown and described in the expired Inwood and Lavenberg box patent, Reissue No. 12,725.

6. In not holding that respondents have already enjoyed, for the full statutory term under the expired reissue patent, the benefits of any invention that was contributed to the art by Inwood and Lavenberg.

7. In not holding that the machine patent is invalid because the mechanism, as shown and described in the patent, is inoperative without the addition of guides for the work-holder, which guides the patentees originally asserted it was their object to dispense with, but which guides re-

spondents subsequently made the subject of another patent (R. 1611).

8. In not holding that the patent in suit is invalid for new matter, if interpreted in the manner set forth in the opinion of the Circuit Court of Appeals for the Sixth Circuit.

9. In not holding that claim 25 is broader than, and/or for a different invention from anything supported by oath of the applicants, Inwood and Lavenberg.

Preliminary Summary of Argument.

The history of the Inwood and Lavenberg inventions, and of the inventions of Rosback, who preceded Inwood and Lavenberg in the same art, is very clearly stated in the opinion of District Judge Raymond, before whom this case was tried in the District Court (24 Fed. (2d) 872). To set forth this history in detail would require, substantially, a copy of Judge Raymond's opinion. We will attempt to summarize this history, and the resulting situation, and the relationship of defendant's machine to both the Rosback patents and respondents' patents involved in the present suit, as follows:

Prior to the entry of either respondents or petitioner into the wirebound box making field, the earlier Rosback inventors had produced, though not very successfully, wirebound box blanks, each consisting of a single sheet of selected veneer, long enough to supply the four sides of a box, and stapled to cleats of substantially the same length. This method produced rigid preliminary blanks which were formed thereafter into flexible blanks by cutting the cleat strips into four lengths, and lightly scoring the veneer sheets along the folding lines to facilitate bending the blank into ultimate box form. The Rosback machines were fully

operative and consisted essentially of endless traveling chains provided with both cleat and sheet pushers and stationary guides for the cleats, the cleats being laid in the stationary guides and moved forward by the pushers, with the veneer sheets resting upon the cleats and the whole passing under suitable stapling machines. Rosback's difficulties resulted from his peculiar box,—from the fact that his complete box blank was made as a single rigid structure, the cleats of which had to be later cut across and the blanks scored to permit folding.

Inwood and Lavenberg, patentees of the patent in suit, improved the box being produced by Rosback by the use of four cleats for each end of the box, and four separate sheets of veneer, one sheet being stapled to each pair of cleats, the parts being assembled and fastened together, so as to constitute a completed blank which, when folded, produced overlapping edges of the side sheets at the corners of the box.

This box was superior to the creased corner box made by Rosback (R. 453) and it was covered and protected by reissue patent 12,725, which was sustained by the courts, and respondents had a monopoly of the manufacture of this box until the expiration of the patent in 1922.

Petitioner has been engaged in building and leasing to box makers, for making the Inwood and Lavenberg box of the expired reissue patent, Rosback type machines provided with extra pushers, thus adapting such machines to feed to the staplers the short cleats and separate side pieces of the expired Inwood and Lavenberg reissue box patent. This, in a nutshell, is the whole story of this case.

Petitioner asserts, as the courts below, with one exception, have held, that in building and leasing for operation the prior art Rosback type machines, with extra pushers, thereby adapting such machines to produce the separate

cleat and side piece blanks of the expired Inwood and Lavenberg reissue patent, instead of producing the long cleat and single sheet side pieces of the blanks made by the prior Rosback machines with single pushers, petitioner has not infringed claim 25 of the Inwood and Lavenberg patent No. 1,128,145 in suit.

Petitioner further urges that if claim 25 of patent No. 1,128,145 in suit be construed to cover petitioner's machine, then it is necessarily invalid as involving nothing more than adding the extra pushers to the prior art Rosback machine, to enable it to produce the separate cleat and side piece blank of the expired reissue patent.

Petitioner further urges that patent No. 1,128,145 is invalid on account of the introduction of new matter, if the specification of said patent is to be interpreted as set forth in the decision of the Court of Appeals for the Sixth Circuit in the instant case.

Petitioner further urges that claim 25 of patent No. 1,128,145 is invalid because it is broader in scope than the disclosure of the application as originally filed and was not supported by supplemental oath.

Petitioner further urges that the patent in suit is inoperative because of the intentional omission of the guides, which latter were thereafter (by a separate patent granted to respondents) made the subject of another patent (R. 1611). The essential guides of the second patent cannot be read into the patent in suit.

Petitioner further urges that the one and only invention involved was covered by the expired reissue patent, as held by the Courts of the Seventh Circuit, and not by the patent in suit, as held only by two Judges of the Court of Appeals for the Sixth Circuit.

ARGUMENT.

This litigation was started in 1922, and originally involved four patents, all issued to Inwood & Lavenberg:

		Appl'n. Filed	Issued
Workholder	No. 1,128,144—	Oct. 14, 1904—	Feb. 9, 1915
Machine	No. 1,128,145—	Oct. 27, 1904—	Feb. 9, 1915
Method	No. 1,128,252—	Apr. 21, 1914—	Feb. 9, 1915
(Box	No. 799,854—	Oct. 17, 1904—	Sept. 19, 1905)
(Reissue	No. 12,725—	June 13, 1907—	Nov. 26, 1907)

These patents all relate to the same subject-matter; that is, the machine, the workholder and the method were all designed for use in producing the box blank of the box patent, reissue No. 12,725. For convenience the reissue patent is reproduced at the end of this brief.

The Patent Involved in This Suit.

The machine of patent No. 1,128,145 (the only patent here involved) is illustrated in the accompanying cut which is Fig. 1 of the patent.

R. G. INWOOD & P. C. LAVENBERG.

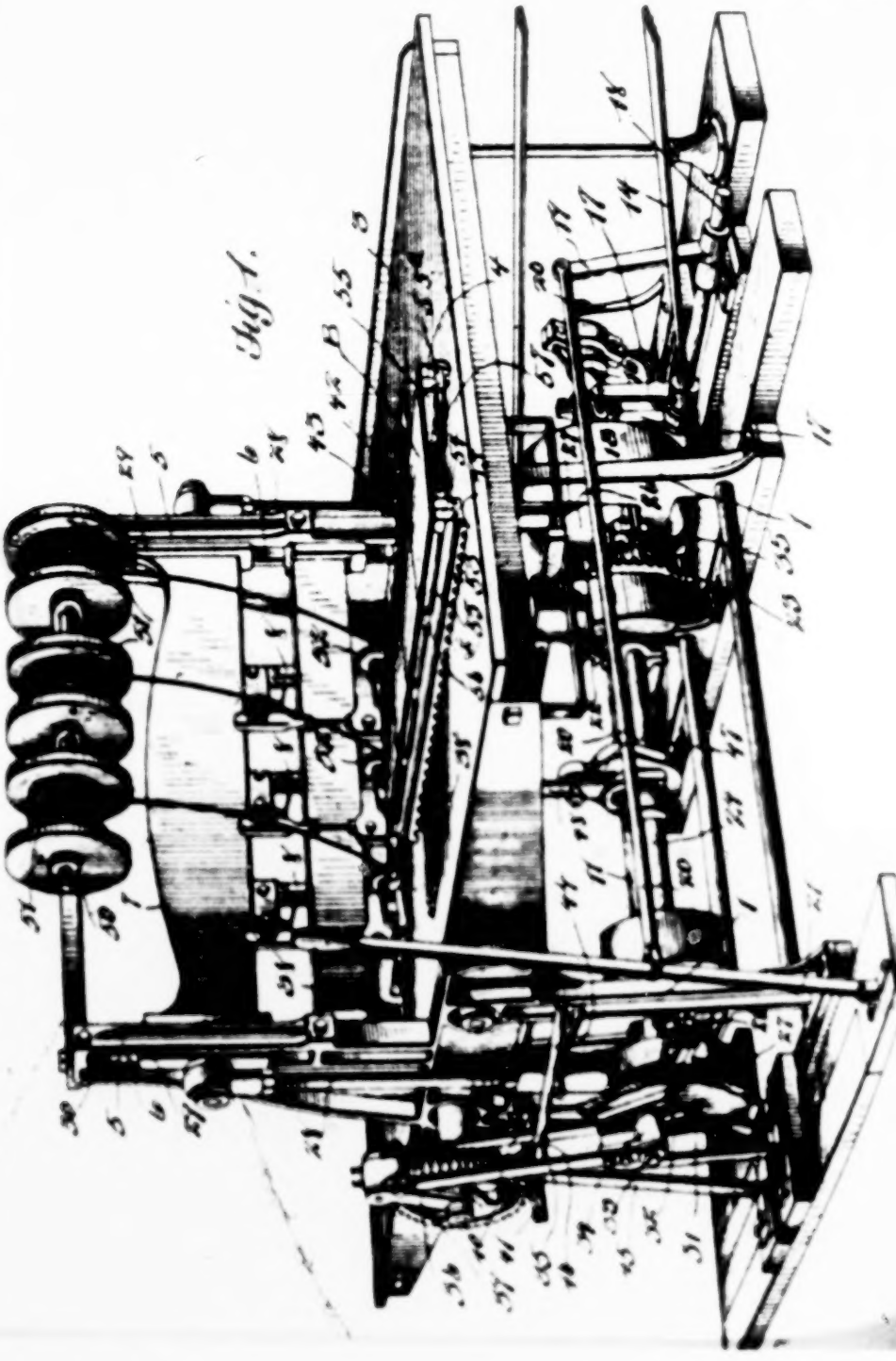
MEANS FOR MAKING BOX BLANKS.

APPLICATION FILED OCT. 27, 1904

1,128,145.

Patented Feb. 9, 1

3 SHEETS—SHEET



This machine consists generally of a flat top table, surmounted by a stapling head for driving the staples over binding wires into the parts that constitute the box elements. This table has an opening arranged transversely near the stapling head for accommodating a wide-toothed pinion 38 or "feed roller," the teeth whereof project slightly above the surface of the table.

This is all there is to the stapling machine of patent No. 1,128,145.

In operation veneer sheets and a series of preformed cleats, four for each side of the blank, are placed in a portable workholder described in the workholder patent No. 1,128,144 (R. 1178). Such a workholder is disclosed again in the patent in suit.

This workholder is illustrated in the accompanying cuts which are Figs. 1 and 5 of the patent.

Inwood & Lavenberg Patent 1,128,144, "Combined Carriage and Former for Wirebound Box Machines." Showing the portable workholder for use in the machine of the patent in suit.

Fig. 1.

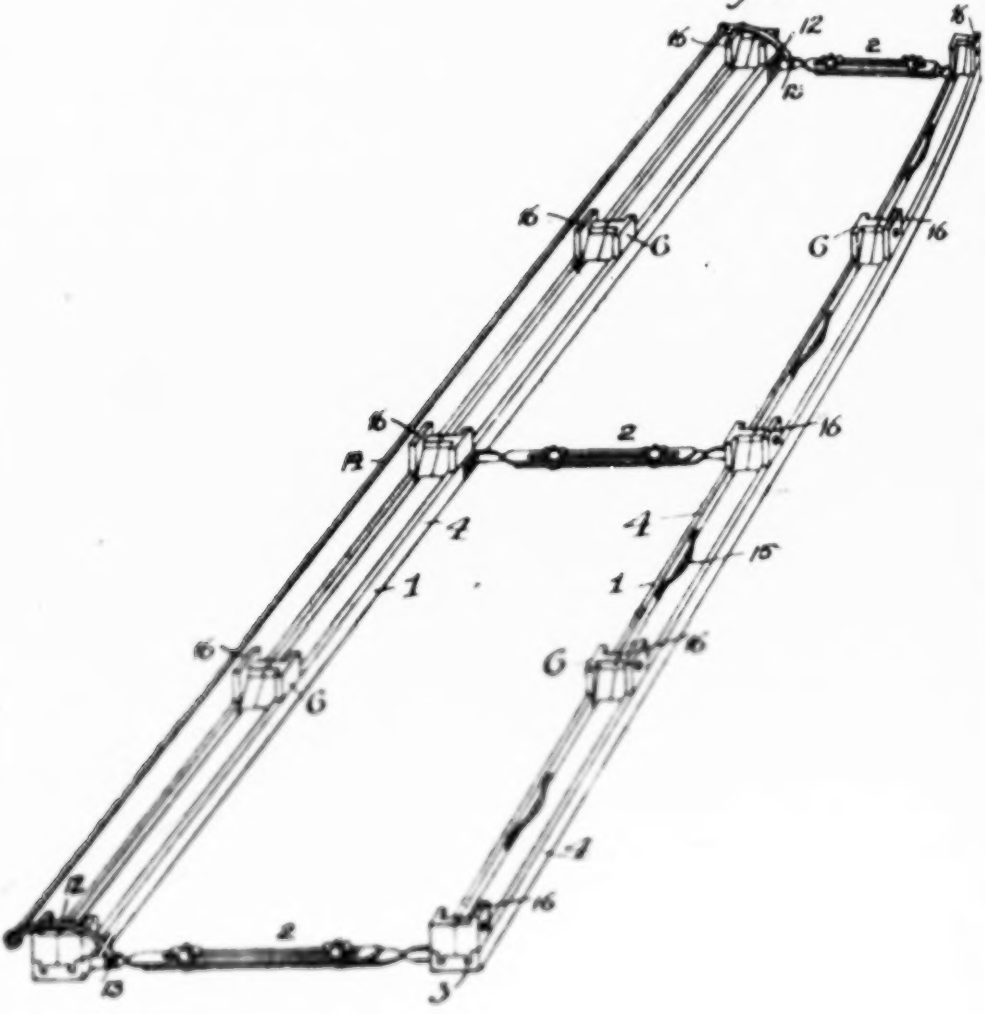
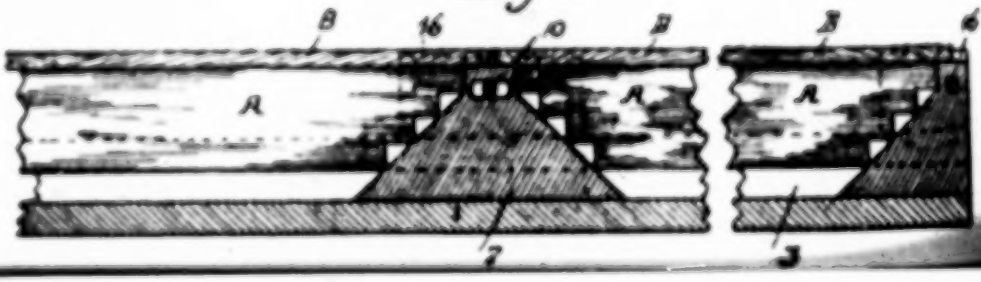


Fig. 5



These workholders are wholly separate and distinct from the stapling machine of the patent now before the Court. Each workholder, removed from the machine, is loaded with eight cleats (A, A, A, of Fig. 5) which are held between the triangular blocks 7 engaging the opposite ends of the cleats and preventing either forward or backward movement thereof. These blocks in the workholder are the "*spacing means to space cleats endwise from each other in each line, preparatory to connecting said cleats in their spaced relation*" called for by claim 25 of patent No. 1,128,145 which is the claim now before the Court.

Judge Denison described this workholder as follows:

> "In substance this workholder consists on each side of four pockets, in each of which a cleat fits closely enough to be held in true position while the cleat and overlying side material are passed under the stapler." (R. 1801.)

When a workholder has been loaded with cleats in each of its pockets, as on a work bench while the workholder is stationary, it is moved bodily by the workman and placed on the table of the machine patent so that the teeth of the feed roller 38 engage a rack 53 formed on the under side of the workholder. The machine is then started. The workholder is presumed to hold the box cleats and side pieces rigidly in position in line with the staplers while they are passing through the machine. The machine has two feed movements, one to bring the workholder up to the staplers, and the other to move it under the staplers. To do this the machine must stop after each blank is finished.

The table top in the machine patent is without guides of any kind. It was presumed (erroneously) that the feed roller would (without any guides for the workholder) cause the workholder to pass straight through the machine.

The application for this patent was filed October 27, 1904,

but it was held in the Patent Office for many years and did not issue until February 9, 1915. Between the time that the application was filed and the time it was issued, many changes were made, both in the specification and in the claims.

The inventors said, page 1 of the original typewritten specification, constituting Defendant's File Wrapper Exhibit 14:

> "It is one of the objects of the present invention to provide *an improved feed mechanism* for this former or carriage *and to dispense with the use of guides* for the blank, whereby the former with the blank therein will have an unobstructed path through the machine, and further to obviate the necessity of adjusting the parts of the machine excepting only the staple drivers for boxes of different sizes, inasmuch as the feed mechanism is adapted to co-operate with any sized formers or carriages, the latter being in themselves laterally adjustable for boxes of different lengths." (Italics ours.)

The machine would be functionless without the workholder, and, in reality, the machine and the workholder are parts of one and the same apparatus, notwithstanding the fact that they are disclosed in separate patents. The patent in suit is inoperative without the guides 7 of the Brown patent No. 1,276,484 (R. 1611). Respondents took out both patents and they are estopped to read these guides from the Brown patent into the patent in suit, as a matter of mechanical skill, as by taking out the Brown patent they have admitted that the necessary guides are not a matter of mere mechanical skill.

The idea of the workholder was to make it possible for the workmen to fill them, at their leisure, away from the machine, and then bring them to and pass them through the machine, while other workholders were being loaded.

The outstanding features of the apparatus for assembling and fastening the box parts were:

1. That the box parts could be assembled in a portable workholder at a point remote from the machine. The workholder could then be passed through the machine and be subsequently unloaded and then reloaded. By thus employing a plurality of portable workholders, the loading and unloading could theoretically be performed with only a minimum of time for stoppage of the machine between blanks, and without reducing the output which the machine itself was capable of producing.

2. The machine was theoretically adapted to receive the workholders without the need of placing the latter in guides and adjusting the position of the guides for boxes of different widths. As the machine had a flat top table, and the feed rollers extended almost entirely across the width of the table, workholders of different widths could be inserted in the machine without requiring any changes in the machine, except the adjustment of the staple drivers. Furthermore, the workholders could theoretically be simply laid upon the top of the machine in engagement with the feed roller, instead of requiring the workholders to be threaded into guides in the machine. The workholder was so formed as to hold the cleats and sheets in their proper relative positions in the manner explained in, and covered by, the expired box patent, reissue No. 12,725.

The following is the single claim of the patent in suit which the Court found to be valid and infringed:

> "25. A machine for making box blanks comprising work controlling means having cleat positioning means to receive sectional cleats in parallel lines, and spacing means to space cleats endwise from each other in each line, preparatory to connecting said cleats in their spaced relation, said work controlling means being arranged to receive side material to be secured to said cleats; fastener applying means for securing binding

means to the side material and cleats controlled by the work controlling means; means for relatively feeding the work controlling means and fastener applying mechanism for securing said binding means across the intervals between said spaced cleats to secure them together in their spaced relations to form a foldable blank."

The Rosback Machine.

Petitioner's machine is simply the prior art Rosback machine with such added pushers on the feed chains as are called for by the character of the blank which petitioner makes. This blank is the one disclosed in the expired reissue patent No. 12,725.

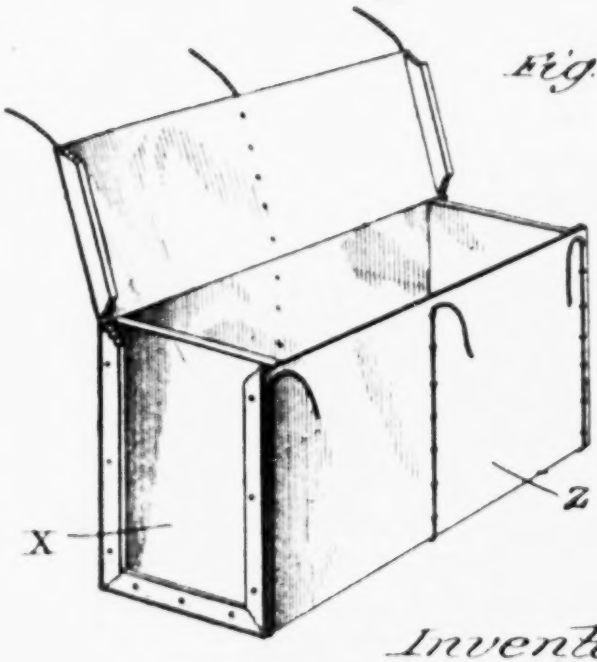
An understanding of petitioner's machine may, therefore, be had by referring to the Rosback machine, which is illustrated in Rosback patents Nos. 614,348 and 625,958 (R. 1407 and 1446). It consists primarily of a stapler, stationary guides for directing the sheets and cleats to the stapler, and endless chains having pushers for feeding the materials along the guides to the stapler. The accompanying cuts are taken from the Rosback patents and are self identifying. (See footnote.)

In Rosback patent No. 608,796, Fig. 2 (R. 1300), the cleat pushers are indicated by H^6, and at least three of them are indicated on each feed chain, and the feed chain is broken away to indicate that a portion of the length has been omitted. The following is quoted from page 4 of the patent (R. 1309):

"Extending over each sprocket-wheel H^3 and its companion sprocket-wheel H^4 is a flexible feed-belt, preferably in the form of a chain H^5, which on the upper side rests and slides upon the guide-strip s^2. Each feed-chain is provided at stated intervals (in the present machine nine feet apart) with stops or cleat and sheet engaging projections H^6, they being on the outer side of the chain to project upward as the chains pass from the sprocket-wheels H^4 to the sprocket-wheels H^3 over the guide-strips s^2."

ROSBACK WIREBOUND BOX.

Fig. 37 of Patent 608,917.



Inventor:
Frederick P. Rosback
By Dyrenforth & Dyrenforth
Attys.

No. 608,796. Patented Aug. 9, 1898.

F. P. ROSBACK

MACHINE FOR MAKING BOX BLANKS

Application filed Nov. 27, 1896.

(No Model.) 14 Sheets—Sheet 2.

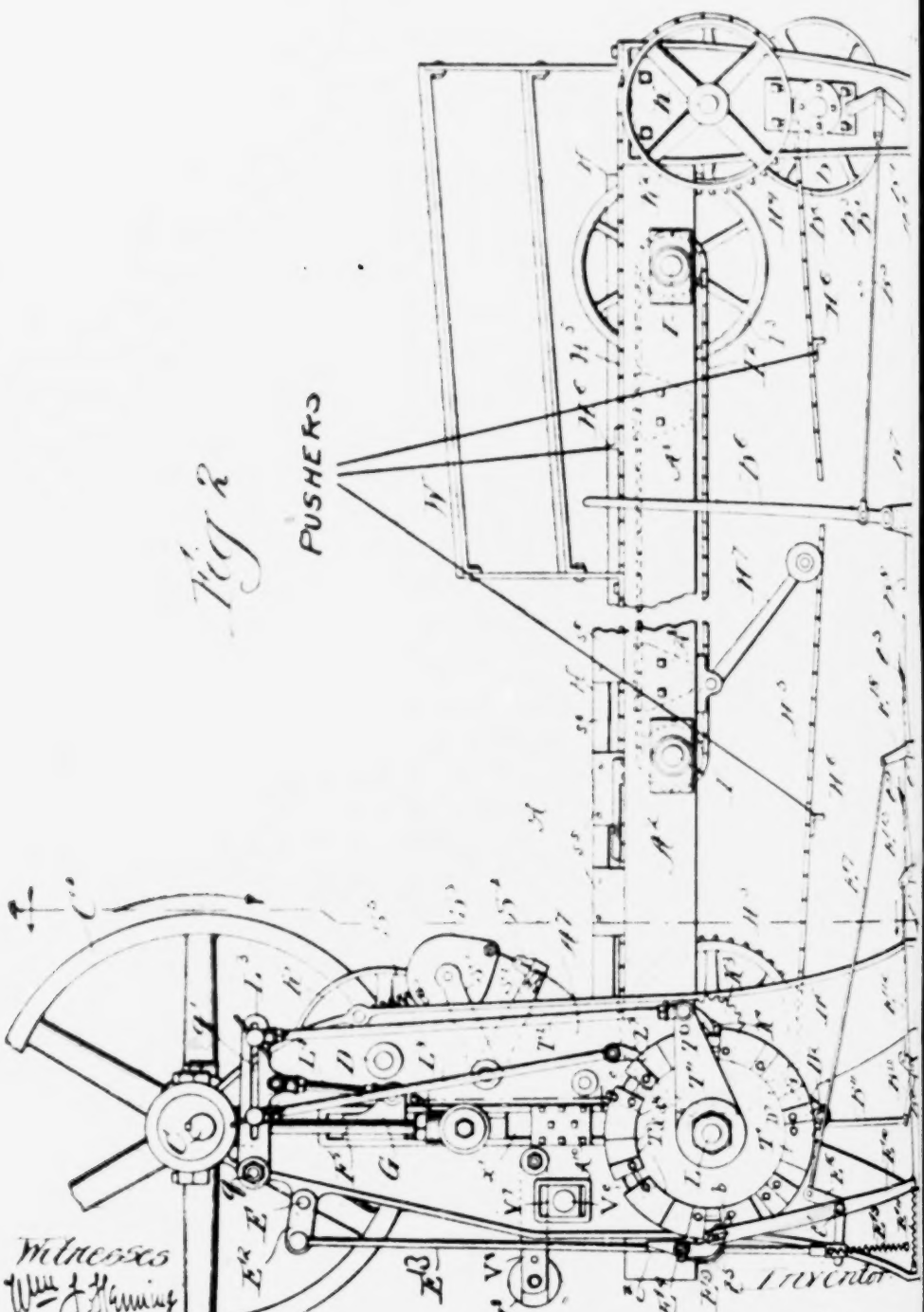


Fig. 2.

Witnesses
Wm. J. Fleming
[illegible] M. Rheem.

Inventor
Frederick P. Rosback,
by Dyrenforth & Dyrenforth,
Atty.

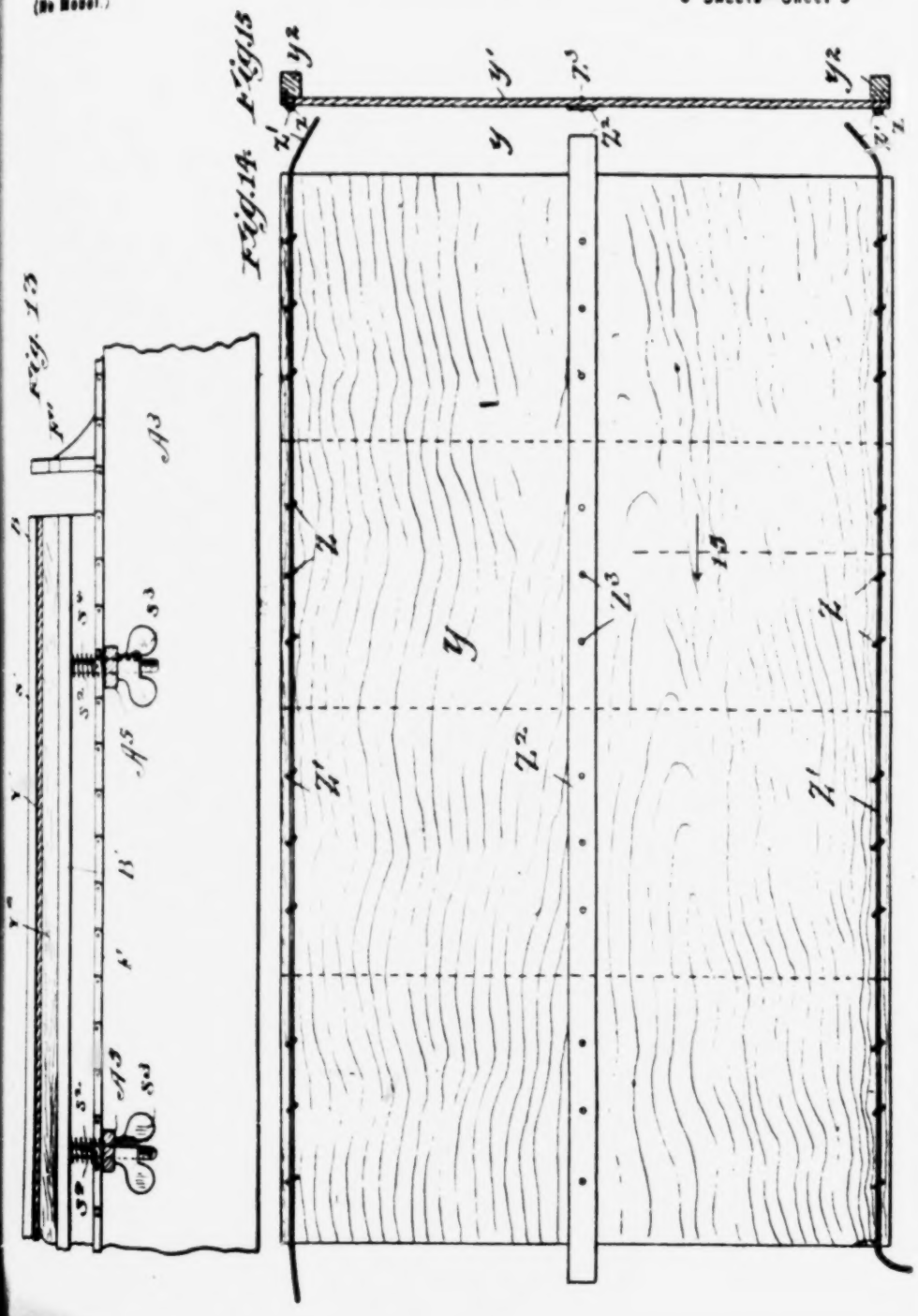
No. 614,348. Patented Nov. 15, 1898.

F. P. ROSBACK.

MACHINE FOR MAKING BOX BLANKS.

(Application filed June 20, 1898.

(No Model.) 9 Sheets—Sheet 9



No. 625,958. Patented May 30, 1899.

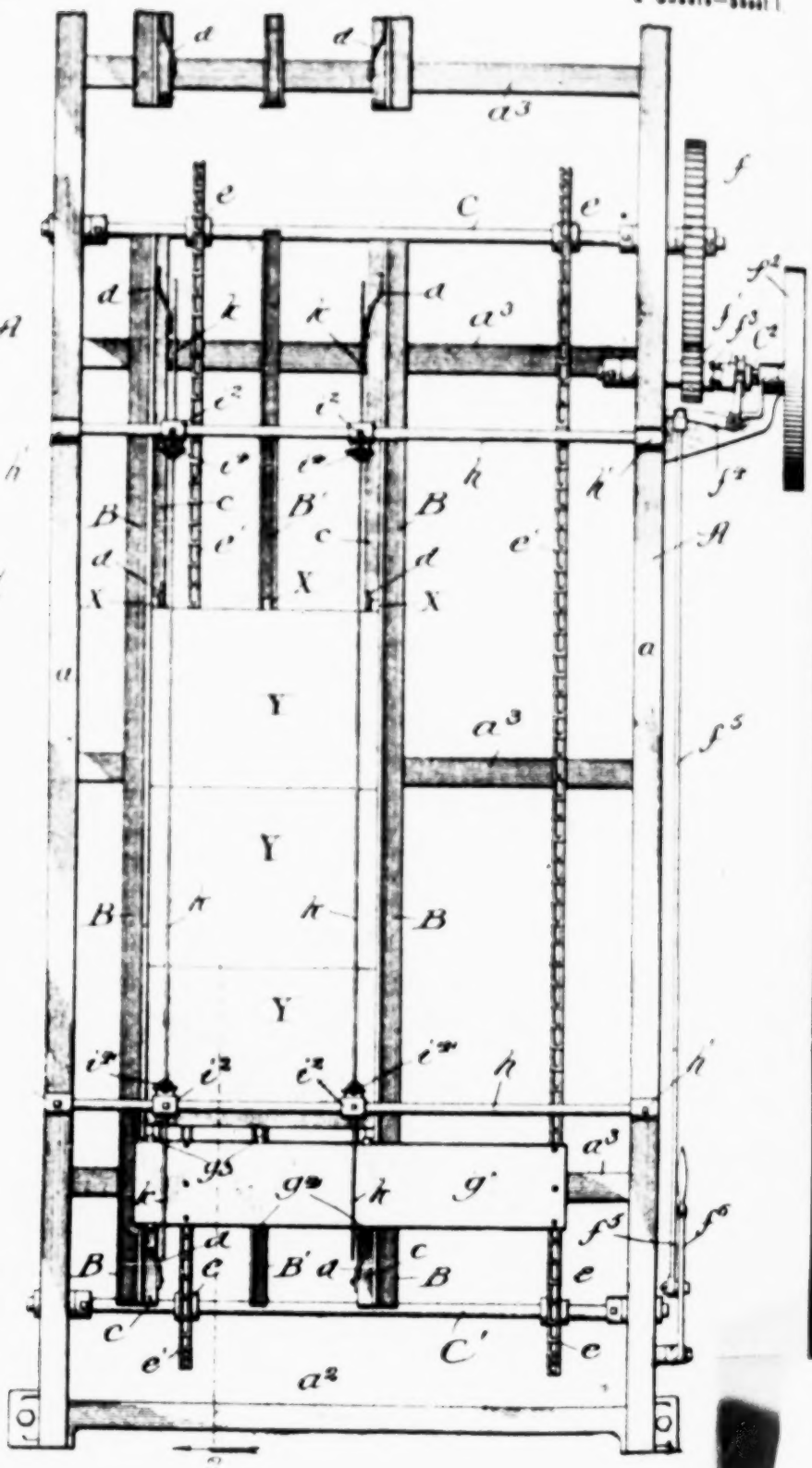
F. P. ROSBACK.

FEED DEVICE FOR BOX BLANK MATERIAL.

(Application filed Feb. 4, 1899.)

No Model.) 2 Sheets—Sheet 1.

Fig 1.



The blank, as it left the Rosback machine, was rigid; that is, the cleats extended from end to end of the blank and were later cut by a "step mitering machine," illustrated in Rosback patent No. 623,258 (R. 1428). As each blank, as it left the Rosback stapling machine, had but one long cleat on each side, each feed chain was equipped with but a single cleat pusher for each blank. In the Rosback blank also, the sheet material, that is, the veneer which formed the sides of the box in the finished article, extended from end to end of the blank, and a step mitering machine cut a groove in the under side of the wood to cause the wood to bend along the proper line when the blank was folded. This blank was known as the "creased" blank, and the operation of cutting the sheet material to promote the folding was known as "scoring."

These Rosback machines produced a limited number of box blanks, which were sold, but the business was new and was not profitable prior to the advent of Inwood and Lavenberg (R. 453), nor for some time afterward. These matters are brought out in Judge Denison's opinion and are not controverted by either side.

The Structure of Petitioner's Machine.

Petitioner's machine (this brief deals only with petitioner's "third" machine, as the Court did not discuss petitioner's "first" and "second" machines) is illustrated in the accompanying cut—Defendant's Exhibit 7 (R. 487).

This machine, as shown by this cut, consists chiefly, except for the stapling mechanism, which is of common structure and mode of operation, of stationary guides for the box parts and feed chains provided with pushers for advancing the box parts along the guides and under the stapling mechanism.

Petitioner's machine is substantially a replica of the Rosback prior art machine, except as to the number of cleat pushers or lugs on the feed chains. Petitioner's machine does not stop between blanks. Rosback clearly had it in mind to vary the distance between the pushers, for blanks of different lengths, but there is nothing of this kind in claim 25 of the patent in suit.

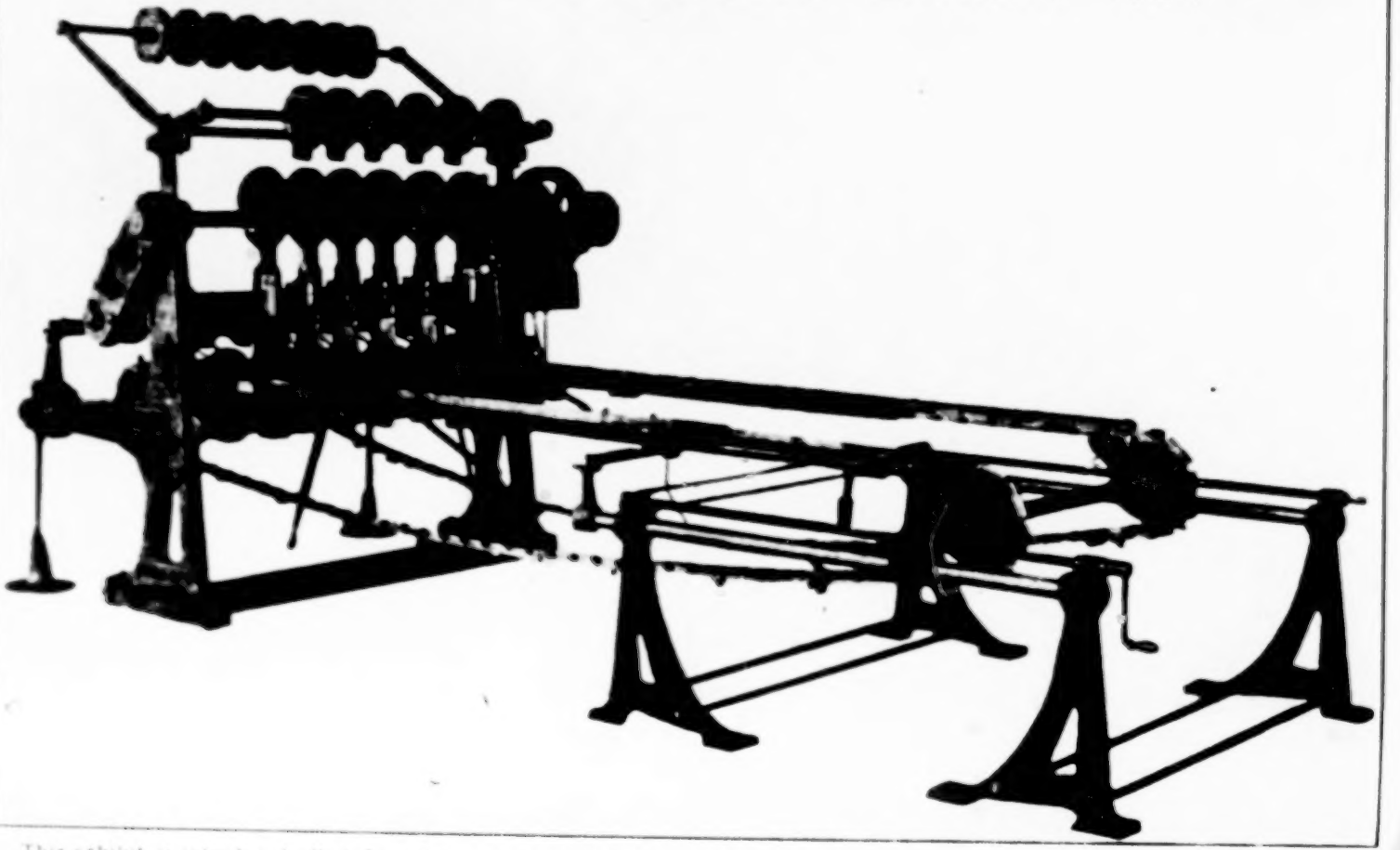
Petitioner, desiring to make the box blank of the expired reissue patent No. 12,725, instead of the long cleated, rigid blank of Rosback, fastened additional pushers on the feed chains to take care of the added number of cleat sections in the blank.

Petitioner also uses sheet spacers and pushers, but these are *not* in the patent in suit.

Petitioner uses springs and other frictional retarding devices, to hold the cleats back against the cleat pushers. These are common in the Rosback patents, as herein pointed out. The Sixth Circuit Court of Appeals laid stress on the fact that petitioner is using "hold backs" in its machines, but there are no such "hold backs" to frictionally retard the cleats in the patent in suit, as in this patent the cleats do not slide in stationary guides, and con-

170 F

DEFENDANT'S EXHIBIT NO.7



This exhibit is introduced [illegible] and is a photographic reproduction of petitioner's machine. It will be observed that it consists of the stapler, guides for guiding the box materials to the stapler and feed chains and pushers for advancing the box materials to the stapler. To the guides and feed chains are connected [illegible]

sequently the cleats have no friction anywhere with anything while traveling bodily with the workholder through the machine. There are no "hold backs" of any kind in claim 25 of the patent in suit. Such things are common in the prior art, and no charge of infringement can be predicated upon the presence of these things in petitioner's machines.

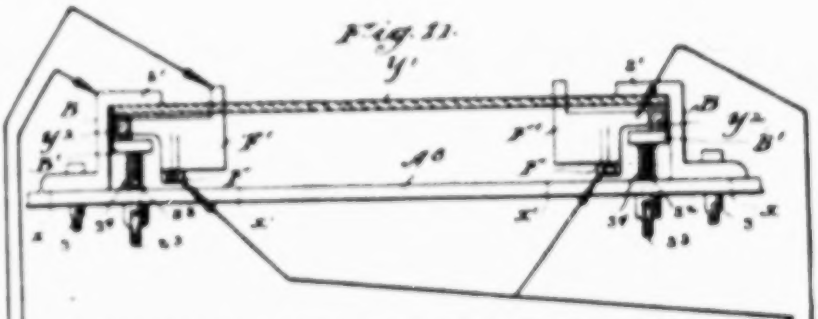
No. 614,348 Patented Nov. 15, 1898

F. P. ROSBACK.

MACHINE FOR MAKING BOX BLANKS

(Application filed June 20, 1896.)

(No Model.) 9 Sheets—Sheet 8



PETITIONER HAS THESE FEED CHAINS.
PETITIONER HAS THESE CLEAT PUSHERS.
PETITIONER HAS THESE GUIDES.
PETITIONER HAS THESE SHEET PUSHERS.
THE NUMBER OF CLEAT PUSHERS IS DETERMINED BY THE NUMBER OF CLEATS TO BE PUSHED, AND BY THE CHARACTER OF THE BLANK TO BE MADE.

Petitioner makes two kinds of blanks; one a full cleated blank, having four cleats in line, as in the reissue patent No. 12,725; and the other an alternate cleat blank in which

each alternate cleat is omitted from the blank, and in the finished box is supplied by the box ends. According to the alternate cleat arrangement, the missing cleats are previously fastened in proper position on the ends of the box, and when the blanks are wrapped around the ends of the box, one cleat is supplied by the blank; the next by the box end; the next by the blank; and the last by the box end. Petitioner, to produce the full cleated blank, fastened three additional pushers to each feed chain so that the four pushers would advance the four cleat sections. In the case of the alternate cleat blank, only one extra pusher is necessary on each feed chain to take care of the two cleats which are secured to each side edge of the blank.

The appearance and relative positions of the cleats, sheets, and pushers for a full cleated blank are shown in the accompanying cut. (Page 25 of this brief.)

It will be observed that the pushers each engage a shoulder on the cleat ahead to push the latter forward along the guide, although there is no engagement between a pusher and the cleat behind it.

As stated, therefore, petitioner's machine is simply the old Rosback machine with the extra cleat pushers called for by the increased number of cleat sections. Petitioner's machine is shown in petitioner's Exhibit 21 (R. 1764). Petitioner patented the feature of having the pushers engage the *shoulders* of the cleats, instead of the extreme rear ends, as in Rosback.

FIG. 1

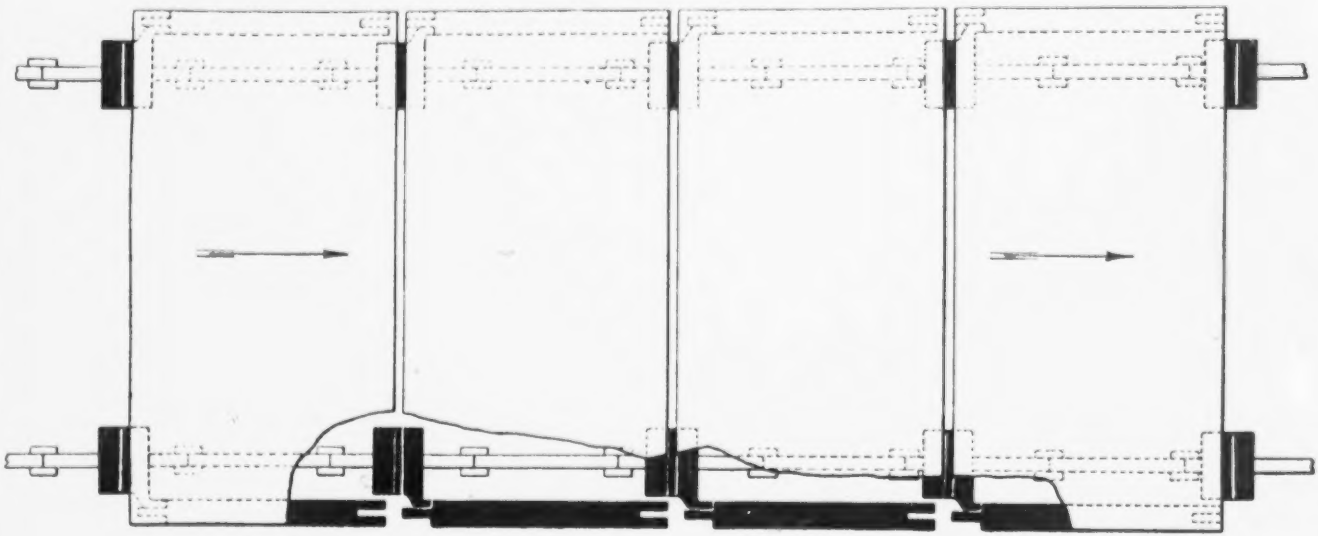


FIG. 2

PETITIONER'S ENDLESS CHAIN
FEED AND PUSHER SYSTEM

The Inwood and Lavenberg Contribution to the Art.

As hereinbefore stated, the rigid blank produced by Rosback was not a commercial success. The record shows that when it became evident that the Rosback rigid blank was not likely to prove a commercial success, respondents' inventors, Inwood and Lavenberg, were called in by one Wm. P. Healy, who was endeavoring to produce boxes of this kind at a profit (R.453). They, Inwood and Lavenberg, discarded the idea of employing long cleats and sheets and cutting the cleats and scoring the sheets after the parts were assembled and fastened together. They decided to cut the cleats and sheets first, and then fasten them together in proper relative position, so that they would fold and produce a wirebound box. They applied for a patent on the idea October 17, 1904, and on September 19, 1905, received patent No. 799,854, which was afterwards reissued as box patent No. 12,725.

It has an important bearing on this suit to know that during the entire time that this box patent was in force (that is, up to September, 1922, when the patent expired) respondents asserted, and the courts held, in substance, that this box patent was the key to the industry and afforded a monopoly of it. Respondents brought suit to enforce it against the Chicago Mill & Lumber Co. in 1914, and the unappealed decision of Judge Sanborn in that case is given in 238 Fed. 929. He described the invention as being of great merit, and said:

> "If it did not actually create the wirebound box industry, certainly it was a most important factor."

When the Gibbons Box Company entered the field shortly before the expiration of the box patent, respondents again brought suit under the box patent, and included the other three patents, which were also involved in the suit against

petitioner in the Sixth Circuit. The District Court, Judge Page presiding, granted a preliminary injunction on the box patent, but at final hearing this was reversed, Judge Anderson presiding, and thereafter the Court of Appeals for the Seventh Circuit sustained this patent and ordered an accounting (25 Fed. (2d) 363).

Petitioner submits, therefore, that respondents enjoyed a monopoly of the industry for the term of the box patent—1905–1922. Notwithstanding this, the majority opinion of the Court of Appeals for the Sixth Circuit holds, in substance, that it is the *machine* patent which is the key to the industry and proposes through that patent to give respondents an extended monopoly of the industry until the expiration of the machine patent in 1932. We submit that there can not be two independent patents, one expiring ten years later than the other, which *both* control the same industry, and it would seem to be equitable that as respondents have enjoyed a monopoly for the statutory period of seventeen years, it should now be held that respondents have had full enjoyment of the fruits of the invention and that the invention should now be open to the public, regardless of whether the invention should have been ascribed originally to the machine patent instead of the box patent.

But regardless of the equities, the box patent taught everything necessary to practicing the invention on the Rosback machine. In other words, as soon as Inwood & Lavenberg, in the box patent, taught the idea of forming cleats and sheets beforehand, instead of after the parts were fastened together, it was obvious that additional pushers should be placed on the Rosback feed chains to take care of the added number of parts.

Respondents' expert, Mr. Arthur S. Browne, practically

admitted this when he testified as follows (R., Vol. 2, p. 662):

"X-Q. 45. What mechanical elements are needed to be added to Rosback to produce defendant's alternate cleated blank?

"A. Sufficient additional pushers located with respect to each other so as to handle the individual cleats and side sheets in such a way that they will be assembled in proper foldable relation.

"X-Q. 46. And a sufficient number would be one extra cleat pusher on each feed chain for each blank; isn't that so?

"A. Yes."

Page 653:

"X-Q. 7. In the Rosback machine, how many cleat pushers are necessary for a blank having two cleats?

"A. Two, one for each of the two parallel cleats.

"X-Q. 8. In the alternate cleated blank, in which the blank is provided with four cleats, how many pushers are required?

"A. Four for the cleats.

"X-Q. 9. Assuming that it were desired to make a six-sided box-blank, as illustrated in Defendant's Exhibit 2, how many pushers would be required?

"A. Assuming that this blank to be made on a machine like defendant's machine or upon a machine like the Inwood and Lavenberg patent, there would be six pushers or spacers, at each side of the machine, or twelve in all.

"X-Q. 10. I will ask you the same question with respect to Defendant's Exhibit 3, which shows an eight-sided box-blank.

"A. There would be sixteen pushers, eight at each side.

"X-Q. 11. In other words, it is true, isn't it, that it is the form of the blank which dictates the number of pushers that must be used?

"A. Yes."

This view, *i. e.*, that the real contribution which Inwood & Lavenberg made to the industry is contained in the box patent, and only in the box patent, has been adopted, in substance, by the Court of Appeals for the Seventh Circuit;

by Judge Raymond of the District Court at Grand Rapids; and by Judge Knappen in the Court of Appeals for the Sixth Circuit. Judge Anderson, who presided in the District Court in the Gibbons suit, gave no written opinion, simply dismissing the bill for want of equity. We will not quote from the opinions, as they are readily available, but the following is taken from the dissenting opinion of Judge Knappen, in which he quoted approvingly the language of the Court of Appeals for the Seventh Circuit (25 Fed. (2d), at page 366) when he said:

> ". . . the moment the long cleat was discarded and supplanted with short ones, the workholder and machine readily appeared as the logical solution of the mechanic to the problem confronting him." (R. 1808.)

In its details of construction, the machine patent in suit may, and probably does, contain patentable subject-matter in connection with the flat top guideless table, the wide faced feed roller, and the portable workholder, with its rack designed to engage the feed roller. But claim 25 is invalid for lack of invention, especially if attempt is made to read it on defendant's machine, which, as above stated, is nothing but the Rosback machine with added pushers to the number called for by the added cleats.

The Reason Why Inwood and Lavenberg Did Not Use the Rosback Machine With Extra Pushers.

These matters have, of course, been discussed at the prior hearings, and six out of the eight judges who have presided have apparently adopted petitioner's view on the question of infringement of claim 25, but respondents have replied that Inwood and Lavenberg were quite familiar with the Rosback machine and that if there was no invention in adding the necessary pushers to the feed chains, and, there-

fore, no infringement of the patent in suit, regardless of whether this patent is valid or invalid, they, Inwood and Lavenberg, would have done that same thing and saved themselves the trouble and expense of making a machine of entirely different design. The answer is simple, but involves a brief understanding of the occurrences which took place during the summer of 1904, when Inwood and Lavenberg applied for their patents.

The reason, and the only reason Inwood and Lavenberg did not use the Rosback machine, was that it was covered by patents owned by an adverse party, and they knew they would be promptly sued if they used the Rosback machine (R. 453-454-455-456). These matters were all brought out in a litigation entitled *National Wirebound Box Co. et al.* v. *Wm. P. Healy*, and the printed record is in this suit as Defendant's (Petitioner's) Exhibit No. 17. (See page 42 of this brief.)

Briefly, the facts are these: The several Rosback patents, and the Knudtson & Uhri patent No. 518,038 (R. 1249) were owned by one Wm. P. Healy, who for some time had been endeavoring to succeed commercially in making wirebound boxes by machinery. He had employed Rosback, and others, and had made box blanks on the Rosback machines, but without commercial success. While still working with the Rosback machine, he called in Inwood and Lavenberg and entered into an agreement with them, by which they were to assist Healy in commercializing the undertaking. The agreement provided that in case Inwood & Lavenberg made any improvements, they were to become the property of Healy (189 Fed. 52).

While this agreement was in force, and while they were working with the Rosback machines, they conceived the idea set forth and patented in the box patent. They believed the invention would be important, and, in disregard of the

agreement they had with Healy, and without Healy's knowledge, they applied for a patent, and proposed to proceed and leave Healy out. However, on account of the fiduciary relationship between themselves and Healy, they were aware that the Rosback machine was broadly covered by Healy's patents, and notably the Knudtson & Uhri patent, which contained claims 1 and 6, claim 1 being set forth in a footnote on this page. It therefore became necessary for them to devise a machine which would not infringe any of the patents owned by Healy.

It will be observed that these claims are limited to a machine having *guides*, and Inwood and Lavenberg knew that in order to avoid these claims, it would be necessary to employ a machine operating without guides (R. 453-454-455-456). They, therefore, designed the machine shown in patent 1,128,145 in suit, and in the application, as filed in the Patent Office, made the statement previously herein quoted, to the effect that one of the objects of the invention was to "dispense with the use of guides for the blank." They submitted the design to one Theodore Dalton, patent attorney of Washington, who gave them an opinion to the effect that this guideless machine was not an infringement of the Knudtson & Uhri patent. Copy of the Dalton opinion was offered in evidence, and marked Complainant's Exhibit No. 141, in

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1. In a machine for forming box blanks by fastening sheets and strengthening wires to reinforcing cleats, the combination of guides for the cleats, intermittent feed mechanism for advancing the cleats longitudinally in their guides and with a sheet through the machine, an intermittently actuated staple driver adjacent to the path of each cleat, alternating in its action with said feed mechanism, to fasten the sheet, by successive operations, to the cleat, and means for guiding strengthening wires with the cleats and sheet across the staple drivers, substantially as and for the purpose set forth.

National Wirebound Box Co. et al. v. *Wm. P. Healy* (Petitioner's Exhibit No. 17). The first four pages of this Dalton opinion will be found at page 456 of the Record in this case.

When Healy discovered what Inwood & Lavenberg were doing, he brought suit to obtain title to the patent applications, and Judge Grosscup, speaking for the Court of Appeals for the Seventh Circuit, held, in effect, that Healy should be regarded as trustee of the said patent applications for the benefit of himself and Inwood & Lavenberg. This opinion is reported in 189 Fed. 49.

We believe that this fully answers respondents' query: "Why, if it was obvious that the Rosback machine could be used for making the Inwood & Lavenberg blank, and Inwood & Lavenberg were familiar with the Rosback machine, did they not employ it for making their own blank?"

The answer is that they knew that it infringed Healy's patent, and they knew that, under these especially aggravating circumstances, Healy would lose no time in suing them, and hence they were forced to plan to employ, should they break with Healy, a machine of entirely different design for the purpose. (Inoperative, absolutely, because of the deliberate omission of the necessary guides.) The Brown machines could use the guides because these machines were Healy's property (R. 453). (189 Fed. 58.) (Vol. I, Healy suit, page 196, Petitioner's Exhibit 17.)

The foregoing presents, in substance, petitioner's case. Petitioner believes, and apparently six of the eight judges who have passed on the merits of the case have agreed,

(*a*) that the Inwood and Lavenberg contribution to the art is disclosed and covered in the box patent, which has now expired;

(*b*) that, as respondents have urged, during the entire lifetime of the box patent, it dominated the art and

afforded a monopoly of the industry to respondents, and it would be unfair now to hold that the monopoly should have been accorded to the machine patent in suit, and the term of the monopoly extended for an additional ten years, or until 1932;

(*c*) that regardless of whether the machine patent in suit shows details of construction which are, or may be patented, and wholly apart from the question of whether this patent is valid or invalid, it was not invention, and therefore not infringement of the patent in suit, after the invention of the box patent was disclosed, to add the necessary pushers to the Rosback machine to make the Inwood & Lavenberg box blank;

(*d*) that when the box patent expired, the invention thereof was open to the public, and that it would be an unreasonably narrow view to say that all that the public acquired, by the expiration of the box patent, was the right to make such a box blank by hand;

(*e*) that the industry should not be further harassed by respondents, or, in any event, everyone should be free to use the old Rosback machine, with any requisite number of pushers added to the feed chains, to make the box of the expired reissue patent.

All But One of the Decisions Below Support Petitioner's Position.

In the opinion of Judge Raymond in the instant suit, it was said:

> "In this case, therefore, the product patent having expired, the public has become entitled to produce the box by the method disclosed by the patent. As previously stated, the reissue box patent expired September 19, 1922, and on that date the defendant and the public had the right to begin making and using the box blank and the method of manufacture thereof dis-

closed by this patent. It appears to the court that, as soon as the method disclosed in the box patent was divulged, it became obvious to those familiar with the prior Rosback invention that, in order to produce the Inwood and Lavenberg box blank, it would be necessary only to add the extra pushers called for by the extra pieces of a different form of blank, and that so to do was a matter merely of the exercise of ordinary mechanical skill. The machine used by defendant is nothing more than the Rosback machine with additional pushers placed on the feed chains. Consequently there is no infringement of the method patent, nor of the machine or workholder patents." (R. 1163.)

Judge Lindley, delivering the opinion of the Circuit Court of Appeals for the Seventh Circuit, said:

> "Furthermore, the workholder patent in suit covers only a specific portable workholder, one of the inherent features of which is that the cleats must be originally placed in correct position. The workholder is not self-correcting, and neither it nor the machine can automatically rectify any longitudinal displacement of the cleats before the side sheets and cleats are fastened together. The defendant's machines and methods on the contrary employ the inherent and fundamental principles of the original Rosback cleat-pusher machine, in which original accuracy of the placement of the cleats is not necessary. So, if the workholder and machine patents were held to be of inventive character, there is no infringement of the specific invention claimed therein." (25 Fed. (2d) 363.)

Circuit Judge Knappen dissenting from the majority opinion of the Court of Appeals for the Sixth Circuit expressed his agreement with the statement of reasons and the logic of the Court of Appeals for the Seventh Circuit in finding those patents invalid (R. 1807).

The effect of Judge Knappen's dissenting opinion is a specific approval of petitioner's position that after the reissue patent on the box expired (which patent really involved the method of making the same) it was open to pet-

tioner to make the box of the expired patent and in doing so "employ the inherent and fundamental principles of the original Rosback cleat-pusher machine, in which original accuracy of the placement of the cleat is not necessary."

Majority Decision of the Court of Appeals for the Sixth Circuit.

The majority decision of the Court of Appeals for the Sixth Circuit finds, however, that petitioner has used the mechanism of respondents' machine patent in suit No. 1,128,145 and not the mechanism of the earlier Rosback patents and it therefore holds that petitioner's machine infringes claim 25 of this patent. In so holding we think that Court was clearly in error for the following reasons:

Petitioner clearly has not used either the guideless flat top table with two long-toothed rollers mounted in the table of the machine to feed a separate and independent workholder to the stapling mechanism, or a portable workholder having self-correcting pockets in which the cleats fit closely while the cleats and overlying side material are passed under the stapler.

On the contrary, as the courts below have held, petitioner's machine is a reproduction of a Rosback machine having guides in which the cleats are placed in proximity to feed chains, which chains are provided with lugs that extend into the cleat guides and engage the rear end of the cleats. These lugs, which act as pushers, are spaced sufficiently far apart on the chains so that as the cleats, and the overlying sheets of side material, are brought under the stapler they are sufficiently spaced to permit the folding of the blank that is thus produced to form a box.

In the majority opinion of the Court of Appeals, it is said:

"What impresses us as the most serious challenge

> to patentability is the claim that when the patent is tested by applying it to defendant's machine and giving it the construction necessary to make out an infringement, we see that all the patentees did was to take the Rosback machine and 'add some extra pushers.' By this is meant that the Rosback machine used two parallel conveyor chains; that each of these chains carried a projection or lug which rested against the rear end of the long unsevered cleat and so pushed the cleats and the attached side material through the machine; and that in defendant's final form of machine it has used these chains and these pushers and in addition has only inserted in the chain, in selected locations, adjustable blocks, which project up between the ends of the preformed cleats, whereby each block serves to push the cleat which is immediately ahead of it.''

This is an accurate statement of some of the features of the Rosback machine designed to feed two long cleats for each box blank, with a sheet of side material placed thereon, so that by this operation the rigid blank of Rosback to be later divided and folded into box form could be produced. But this is *not* an accurate statement of petitioner's contention. (See page 56 of this brief.) ''Patentees'' used a portable workholder and no guides, which petitioner has always said was different from Rosback, but *petitioner* has used guides and feed chains and pushers, which *is* like Rosback.

In order to produce the box of the expired Inwood and Lavenberg reissue patent, which became public property upon the expiration of this patent in 1922, petitioner adds three other blocks or cleat pushers for each blank to each of the Rosback chains. As correctly held by the Court of Appeals for the Seventh Circuit neither the Rosback original cleat-pusher machine, nor petitioner's machine, requires any accuracy of placement of the cleats in the guides. It is only necessary with Rosback to drop the cleats into the guides so that their rear ends will be engaged by the pusher blocks as the chains move along in the

guide. Rosback uses springs to retard the cleats and hold them back in accurate position against the pushers. Likewise in petitioner's machine the cleats are dropped into the guides, one in front of each moving pusher block, without any accurate or special placement. As the pusher blocks overtake and engage the rear ends of the cleats they are moved forward by the chains. This is the only positioning of the cleats by any mechanism of the petitioner's machine. It is true that there is some friction between the cleats and the walls of the guides but this is required only to cause the pusher blocks to firmly engage the rear ends of the cleats, and as we shall show, Rosback used exactly the same friction means for the same purpose.

In the opinion of the Court of Appeals for the Sixth Circuit, it is said:

> "The pusher of Rosback was a pusher and nothing else; *it had no substantial positioning function;* the long cleat did not have to be positioned in any such secondary way; it was positioned with reference to the stapler by moving the chains. The defendant's machine uses on each side five of these devices which counsel now call pushers. They are all movable upon the chains for positioning purposes." (Italics ours.)

In reference to this last statement the only "movement" (adjustment) of the pushers upon the chain is one that permits the same machine to be used for larger or smaller boxes. If the boxes are small and the cleats correspondingly short the distances between the pushers on each chain are necessarily less than they are if larger boxes are to be made requiring longer cleats. In every instance, however, the only positioning of the cleats in the guides in petitioner's machine is brought about by the engagement of the pushers with the rear ends of the cleats as the pushers move along in the guides and thereby come in contact with

the rear end of the cleat. This is exactly as Judge Lindley pointed out, in delivering the opinion to the Court of Appeals for the Seventh Circuit, not the method of the patent in suit, but petitioner employs "the inherent and fundamental principles of the original Rosback cleat-pusher machine, in which original accuracy of the placement of the cleats is not necessary."

Further referring to the pushers on the chains of petitioner's machine, the Court of Appeals for the Sixth Circuit, said:

> "The rear one, while it positions the rear cleat rightly with reference to the stapling which is to follow, may be said to have, directly or indirectly, a pushing function exercised upon *all of the parts ahead of it.*" (Italics ours.)

In this statement the Court is clearly in error. In petitioner's machine the rear pusher acts only upon the rear cleat by engaging the rear end thereof. It has no pushing function upon any of the other cleats or their pushers.

So with reference to each of the other pushers, they have no pushing function upon the pushers or cleats ahead of the cleat which is in actual contact with such pusher, nor any pulling function upon the pushers or cleats in the rear. We have already pointed out that in petitioner's machines the cleats are shorter than the distances between the pushers, so that each pusher has no possble positioning effect upon the cleats behind. Its only positioning effect is that, acting upon the principle of the Rosback machine, it engages and pushes the cleat ahead of it.

Again the Court of Appeals for the Sixth Circuit says:

> "The next three of these devices have no necessary pushing function. The same pushing of all the cleats through the machine would follow if these three were of proper spacing size but had no connection with the traveling chain; (*e. g.*), were dropped in from above. They are primarily positioners; such pushing function

> as they have is incidental to their positioning function upon the traveling chain and is not necessarily inherent; they are essential to the positioning, but the pushing could be done in a variety of ways."

The answer to this statement is, that while perhaps "the pushing *could* be done in a variety of ways," it is only done in one way in petitioner's machine, and that is the Rosback way. Moreover, it is not correct to say that these devices are primarily "positioners." They are primarily pushers of the Rosback type. Each one acts upon the rear end of a cleat exactly as do the pushers of the Rosback machine. The length of the cleat has no effect upon the operation of the pusher blocks. The pusher acts just the same and the cleat moves forward just the same whether the cleat is long or short, and whether it is a single cleat, to which is to be stapled one end of a sheet wide enough to form the four sides of a box, or is one of a series of four cleats to which is to be stapled one end of a narrower sheet designed to form one side of a box.

But as we shall show, Rosback's cleat pushers had to be accurately positioned, and, furthermore, it was common practice in the art, as shown, for example, by Greenstreet, and Lipps and Springer (R. 1288, 1291, 1520) to hold the parts of the blank in spaced relation while the stapling mechanism was applying the binding wires, and using lugs or pushers on the feed chains for the purpose of both pushing and positioning exactly as in petitioner's machine.

It is clear that in comparing petitioner's machine with the machine of the patent in suit, the comparison must be made with petitioner's machine as it actually exists, and not with a modified construction which the Court assumes might be employed in place of that actually used by petitioner, and which assumed construction the Court considers would be an equivalent of the structure of the patent in suit. In petitioner's machine the cleats and sheets are

placed in the machine while the machine is running and while the pushers are advancing.

The Court's suggestion, therefore, that three loose blocks of proper spacing size, having no connection with the traveling chain, might be dropped in from above, in petitioner's machine, to take the place of the three pushers fastened to the chains in advance of the rear pusher and that such blocks would be primarily positioners, is wide of the mark, since no such construction, so far as this record shows, was ever employed by petitioner or any one else. Such a construction would be wholly impractical as it would require an operator, standing by the machine, to first drop into the guide the cleat that is to be engaged by the advancing rear pusher. He would next drop in a positioning block in front of this cleat, which would have traveled some distance ahead with the chain. The operator would have to repeat this operation, dropping in four cleats, beginning with the rear cleat, and dropping in three positioning blocks one ahead of each of the first, second and third cleats, counting from the rear. It is submitted that this would be a wholly impractical mode of operation, even more impractical than that disclosed in the patent in suit, in which, as we have pointed out, the cleats are loaded into the workholders between the positioning blocks while these workholders are wholly removed and separated from the machine, which are then required to be moved bodily by the operators after they are loaded. brought to the machine and placed upon the flat top table with the racks on the bottom of the workholders in engagement with the long-toothed rollers arranged in openings in the table top. And, of course, all this is not what petitioner does and is beside the point.

As compared with either of these operations,—the one suggested by the Court of Appeals for the Sixth Circuit, and the other disclosed in the patent in suit,—we have the

operation of petitioner's machine, reproducing exactly the operation of the Rosback machine, in which the cleats are dropped into the guides, and the rear end of each cleat is engaged by a pusher block brought forward by the chain, the only difference being that Rosback has a single cleat and a single pusher for the side edge of each blank, while petitioner has a single cleat and a single pusher for each end of each side section of a box blank like that of the expired Inwood and Lavenberg reissue patent.

It was clearly not the invention of the patent in suit, with its provision of portable workholders, each capable of having a series of cleats loaded therein, the workholder being adapted, after loading, to be passed through a stapling machine, that inspired the production of the box of the expired reissue patent, which patent was sustained by the courts, so that respondents enjoyed a monopoly of the wirebound box business until the expiration of the reissue patent in 1922.

On the contrary, as the courts below, with one exception, have held, it was the invention of the box of the expired reissue patent that brought about the modification of prior existing machines to make the box.

When this box was invented all that was necessary to do to the Rosback machine, to adapt it to produce the box, was to add the necessary extra pushers to that machine.

This is admitted by respondents' expert Browne:

> "X-Q. 227. Suppose a man having ordinary skill in the box making art and familiar with the Rosback and other machines of the prior art were told to take a Rosback machine and adapt it to make a blank in accordance with the method described in your answers to X-Qs. 193 to 197, both inclusive, would he have to do anything more than add some pushers in proper position to the feed chains?
>
> "A. No." (R. 702.)

The fact is,—it was the blank itself which told the peti-

tioner what to do, and which dictated what would have to be done to the Rosback machine in order to make a blank having a different number of cleats.

Petitioner, it is important to keep in mind at this point, has shown that the inspiration for the freak guideless machine of the patent in suit was the fear of infringement of the Knudtson and Uhri patent. According to the record (see Master's report, volume I, page 200, of record in Healy litigation, Petitioner's Exhibit 17), the National Wirebound Box Company was organized October 7, 1904, by Inwood and Lavenberg and others to fight William P. Healy, and it has been shown that a part of this attack on Healy was the filing of the application for the patent in suit, without guides, to make a showing of non-infringement. However, Healy himself, and his licensee, South Bend Healy Box Company, were using the Brown machine that had guides (R. 453, 456, 1163). One of respondents' principal witnesses, Guilford C. Babcock, says that he saw one of the first chain feed machines for making the Inwood and Lavenberg box, in 1906, according to his best recollection. (R. 218, 219 and 220.) By that time Healy himself was using chain feed (Miller patent, R. 1584-1598), with guides for the chains, as he had a right to do under his Knudtson and Uhri patent covering the guides broadly.

There is no proof that any guideless portable workholder machine of the kind disclosed in the patent in suit was ever made or used. (See page 61 of this brief.) There is no proof that more than two, or perhaps three, of the Brown machines with guides were ever used. Obviously, no one had any faith in the guideless workholder machine of the patent in suit. They had very little faith in the Brown machine that had the guides, for there were only two or three of these, and respondents

admit that the several hundred machines made and used since then were all chain feed machines. The guideless machine of the patent in suit was an impossibility, and the Brown machine, even with its guides for the workholders, was commercially a fallacy. And, as we have shown, Inwood and Lavenberg, in their preparations to fight Healy, would have used guides and chain feed had they not been afraid of infringing Healy's broad patent, for it was recognized as early as 1906, and even earlier, that endless chain feed, using the Rosback principle, was the proper and logical thing for the production of the Inwood and Lavenberg box blank, and since then, the endless chain feed type of machine has been the only thing in use by respondents' licensees.

The Rosback Cleat Pushers Were Also Positioners, and the Idea of Controlling the Spacing by Means of Pushers on the Feed Chains Was Well Known at the Time.

Referring again to the statement in the majority decision to the effect that "The pusher of Rosback was a pusher and nothing else. It had no substantial positioning function; the long cleat did not have to be positioned in any such secondary way."

This is obviously erroneous. The pusher of Rosback was not only a pusher; it was also a positioner. The Rosback cleat had to be positioned accurately relatively to the cleat on the opposite side of the blank. Obviously his cleat pushers could not be placed at random. Respondents may reply that, even so, the pushers are positioned side by side, but not in the same line. But the idea of definitely positioning box parts by definitely positioning pushers relatively to each other *on the same feed chain* was equally old in the art: For example, in Greenstreet No. 547,486 (R.

1288) and No. 579,574 (R. 1291), and in Lipps and Springer No. 801,998 (R. 1520). The machines of these patents are of the same general type as Rosback, being provided with stapling heads, guides for the slats, and feed chains with pushers for both advancing the slats and definitely spacing them relatively to each other. For convenience some of the figures of the drawings of Lipps & Springer and Greenstreet are reproduced at the end of this brief.

In Lipps and Springer, the pushers and spacers on the feed chains are marked 16. In Greenstreet 579,574, the pushers and spacers on the feed chains are marked *f*—see especially Figure 5 (R. 1290), and also reproduced at the back of this brief. The type of crate is shown in the accompanying cut taken from Greenstreet 547,486.

(No Model.)

J. H. GREENSTREET.

SHIPPING CRATE.

No. 547,486. Patented Oct. 8, 1895

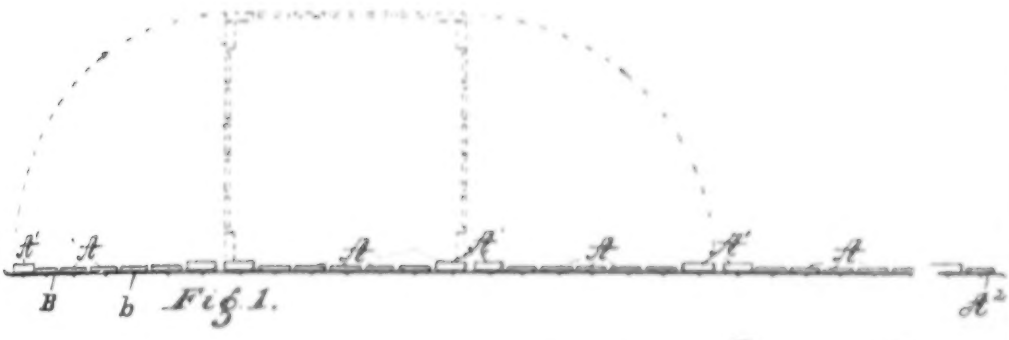

Fig. 1.

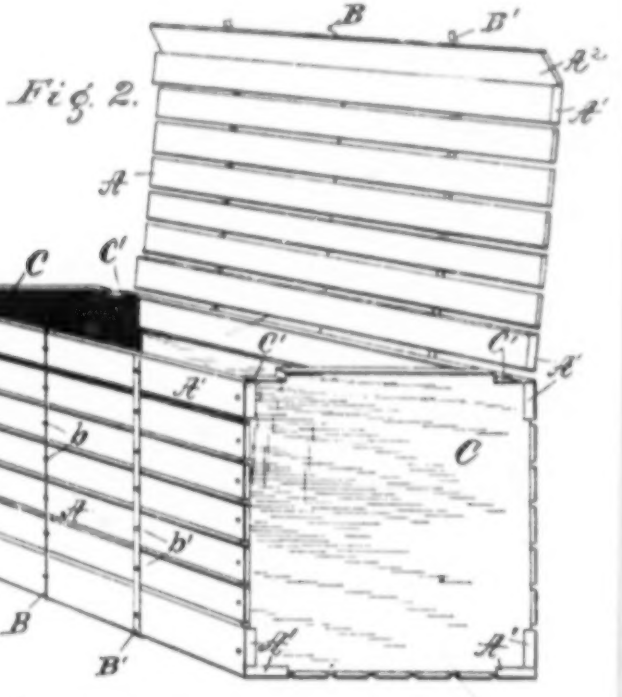

Fig. 2.

Fig. 3.

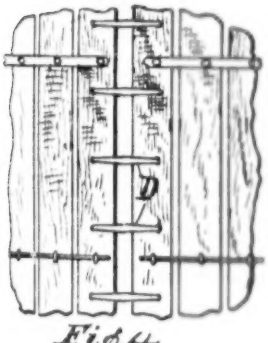

Fig. 4.

NOTE LAP CORNERS.

These required accurate spacing of the slats A and A' and this spacing was accomplished by the pushers on the feed chains. See Greenstreet Machine Pat. No. 579,574 (R. 1291).

A glance at Greenstreet will show that it is essential that the slats be accurately positioned. Otherwise they would not conform to the ends of the box and fold properly at the corners. Attention is called to the added fact that the slats are of different thicknesses, the thicker ones being placed at the corners of the box, *and in such foldable relation as to make a lap corner.*

Thus it is evident that the Rosback patent itself teaches the idea that a plurality of pushers must be definitely positioned with relation to each other in the same blank; and other prior art patents, such as Greenstreet, and Lipps and Springer, show a variation of the idea; that is, the pushers must be accurately positioned on the *same* feed chain, and when thus accurately positioned, can produce a lap corner box. The Court, therefore, was evidently in error in saying that "The pusher of Rosback was a pusher and nothing else." The Rosback, Greenstreet, and Lipps and Springer patents all show that it was perfectly well known in this industry that a definite and accurate positioning of the parts could be obtained by properly positioning the pushers on the feed chains. Greenstreet and Lipps and Springer machine drawings are reproduced at the back of this brief.

In this connection, it should be remembered that at the date Inwood and Lavenberg entered the field, automatic machinery was known in a great many industries, including this particular art, and methods and expedients were a matter of every-day knowledge and common practice to men familiar with these industries.

In the case at bar, it is evident that wirebound containers of various types were known, and it was known that different parts of the containers could be held in definite proper relative positions during the stapling operation by means of pushers and other things on the feed chains which advanced the work to the stapler.

The failure of Rosback's method from the commercial standpoint was due rather to the type of blank than to the machine, and while it was necessary to adapt the Rosback feed chains to the Inwood and Lavenberg blank by adding pushers to the feed chains (in petitioner's machine), this sort of adaptation was well within the expected skill of a mechanic who was familiar with the industry.

As this Court has said in *Aron* v. *Manhattan Railway Co.*, 132 U. S. 84, 90:

> "It rarely happens that old instrumentalities are so perfectly adapted for a use for which they were not originally intended as not to require any alteration or modification. If these changes involve only the exercise of ordinary mechanical skill, they do not sanction the patent; and, in most of the adjudged cases where it has been held that the application of old devices to a new use was not patentable, there were changes of form, proportion, or organization of this character which were necessary to accommodate them to the new occasion."

We submit that after respondents' patentees had disclosed the box of the reissue patent, and the method which that patent necessarily disclosed for making the box, it did not require any inventive genius to add one or three pushers on each Rosback feed chain to produce the Inwood and Lavenberg blank, and this is true, even if the Court of Appeals for the Sixth Circuit is correct in saying that the additional pushers are positioners as well as pushers.

The majority opinion states that petitioner's machine has five pushers on each chain for each blank. This is apparently mentioned for the purpose of demonstrating that a pusher is a hold-back as well as a positioner. But the Court was in error on this point, because only four cleat pushers are used on any feed chain for any eight-cleated blank. The so-called fifth pusher belongs to a different group.

The Court also alludes to the fact that petitioner's machine has means for holding the cleats in contact with the pushers during the stapling operation. But the Court overlooks the fact that exactly the same thing for the same purpose was provided in Rosback's machines. Friction retarding means are shown, for example, in Fig. 11 of Rosback patent No. 614,348 (R. 1407—Folio 1447-1448). The springs s^4 press upward on the bars B′, which form the bottom of the cleat guides. The same purpose is served by the springs *d* rubbing against the inner sides of the cleats X, as shown, for example, in Fig. 1 of Rosback patent No. 625,958 (R. 1446).

If the cleat pushers in the Rosback machines had no positioning function, what difference would it have made whether the cleats were in contact with the pushers or not? The fact is that it was essential to the production of a proper blank to have the cleats in contact with their cleat pushers, and to have the cleat pushers occupy a definite relation with reference to each other.

In view of the teachings of Rosback and of Greenstreet, and Lipps and Springer, it is immaterial whether petitioner's machine employs the friction retarding means of Rosback, or the definite spacing means of Greenstreet, or the pushing and spacing means of Lipps and Springer.

Parenthetically, it is also of interest to observe that Rosback also provided friction retarding means for holding back the *sheet* material (veneer) to insure that it would be in contact with the sheet pusher at the time it was passing beneath the stapler. See the shoe *k* in Fig. 2 of Rosback patent No. 625,958 (R. 1446—Folio 1499-1500).

The Process for Making the Box Blank of the Reissue Patent No. 12,725 Was Necessarily Disclosed in That Patent, for This Patent Deals as Much With Preformed Cleats as it Does With Side Material.

At various points in this brief, we have stated that the expired reissue patent not only disclosed the article; that is, the box blank, but also the method of making it.

In the first place, the public would receive no benefit, after the expiration of an article patent, if the specification did not also impart the necessary information as to how to make the article. Such disclosure of the method is required by the statutes, and Section 4888 of the Revised Statutes is copied in the margin.

Furthermore, the idea of preforming the cleats and preforming the sheets is inherent in said reissue patent. The patent explains what the trouble was with the old methods, such as Rosback's, in which the *cleats* were step-mitered, and the sheets were scored *after* the sheet material and the cleats were secured together. The majority opinion of

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SEC. 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, *and of the manner and process of making, constructing, compounding, and using it,* in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. (Italics ours.)

the Court of Appeals for the Sixth Circuit was in *error*, therefore, in stating that the reissue box patent deals only with "the selection and treatment of side material." *The preformed cleats, the thing upon which the patent in suit is built, is an essential part of the expired reissue patent.*

Patents are addressed to those skilled in the art, and anyone skilled in the art would, upon examining the reissue patent, understand that the parts were to be preformed and were to be held in the specified relationship during the stapling operation.

The Patent in Suit Is Not a Pioneer.

As petitioner's machine does not have any device corresponding to the separate workholder of the patent in suit, in which the cleats fit closely in pockets formed by the spacer blocks, but, on the contrary, has parallel stationary guides along which the cleats are caused to travel by pusher blocks on the chains, identically as in the prior Rosback patent and machine, the Court of Appeals for the Sixth Circuit apparently experienced difficulty in finding infringement, but finally decided to hold petitioner's machine to be an infringement on the theory that the patent in suit was a pioneer and hence should be accorded a liberal scope.

The Court concedes that even if petitioner's structure is to be considered as having four pockets, each of which holds and positions its cleat, there is no direct contact between any one of petitioner's positioning blocks (as the Court designates them) and the following cleat. (R. 1802.) The Court says that in the machine of the patent in suit "the dividing partitions positively position the cleats in both directions,—that is, each partition bears against the cleat behind it as well as the one ahead, while in the defendant's structure the positive contact of the positioner

is only with the cleat ahead of it." (R. 1802.) These certainly represent different "ideas of means." In order to find infringement, the Court has to take the view that the teachings of the patent in suit are so broad as to cover stationary guides and endless feed chains, notwithstanding the fact that the only showing was a portable independent workholder and a guideless table provided with a wide gear wheel.

We submit that the patent in suit is not entitled to any such broad interpretation. We have already shown that the Court of Appeals for the Seventh Circuit, in passing upon the title to the inventions many years ago, held that the patents were "mere improvements upon and extensions of this art," and that later Judge Sanborn, presiding in the Federal District Court at Chicago, held that it was the box patent that was the important factor, and we have shown that Rosback contains everything used by petitioner, including the frictional retarding means for the cleats and the guides, with the exception of the additional pusher blocks, which were in common use in this industry at the time, even to the extent of forming pockets for definitely positioning the slats of a blank while the binding wires were being applied by the stapler head.

We submit that it is quite unjustified to hold that the patent in suit is a pioneer in the art and is entitled to such broad scope as to cover a machine so different in construction and principle of operation.

The moment the long cleat was discarded and supplanted with short ones, the workholder and machine readily appeared as the logical solution of the mechanic to the problem confronting him (R. 1808). This was the position of the Court of Appeals for the Seventh Circuit; of District Judge Raymond in the present suit; and of Judge Knappen, of the Circuit Court of Appeals for the Sixth Circuit, as expressed in his dissenting opinion.

Under these circumstances, the patent in suit cannot properly be given a pioneer status, or be held to be entitled to such a broad scope as has been accorded to it by the Court.

It is difficult to see any infringement of claim 25 of the patent in suit by petitioner's machine, even though the patent in suit be given a liberal scope. The two structures have no elements or devices in common. The machine patent in suit, so far as it consists of anything beyond an ordinary stapling mechanism arranged upon a table that is provided with a long feed roller, is made up of the details of the workholder, into which the cleats are placed before the workholder is put into the machine. Petitioner's structure is so radically different that there should be no question of infringement.

"Prevision" Not Shown.

The majority opinion of the Court contains the following:

> "As to the suggestion that the conveyer chain form of defendant's machine is so different from the patented form that it should not be contemplated as intended to be reached, we may cite a paragraph of the specification which is here quoted in the margin. It would almost seem that the *draftsman had prevision* of the specific form which defendant's infringement was to take, many years later." (R. 1803.) (Italics ours.)

The paragraph referred to by the Court is printed in a footnote hereto.

"We wish it to be understood that this invention is not to be limited to the use of removable carriages or formers such as described, and which are in the nature of adjuncts applicable to the wire feeding and stitching machine. Any means for positioning the separate parts of the blank material in proper relation, as broadly defined in the claims, may be substituted for the formers, or carriages described,

The Court evidently attached considerable importance to this paragraph, and in so doing was apparently under a considerable misapprehension. In the first place, the paragraph was not contained in the application as originally filed, but was inserted by amendment some seven or eight months after the application was filed, and several months after the Patent Office Examiner had cited, among several patents in the prior art, Uhri No. 608,809 (R. 1328), with its sheet and cleat guides for making foldable wirebound box blanks, and Greenstreet No. 579,574 (R. 1291), which shows chain feed with lugs on the chains which act both as pushers and hold backs, thus definitely positioning the slats of the blank with reference to each other. (See Defendant's Exhibit 14, File-Wrapper of Patent in Suit.)

It did not constitute *prevision* at all, but simply the natural observation of the "draftsman" that chain feed was appropriate for the purpose of making the box blank of the expired reissue patent No. 12,725. The fact is that chain feed was the natural and accepted way of accomplishing the purpose, and we submit that the invention, such as it was, consisted in the particular and peculiar machine having the flat top table, the wide feed roller, and the portable workholder.

Another evidence that chain feed for making wirebound box blanks was obvious as soon as the Inwood and Lavenberg box blank became known, and was already supplant-

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whether removable from and replaceable in the machine; or otherwise. In operating the apparatus shown and described, the carriages or formers may be fed into the machine one after the other in a manner to obviate the necessity of stopping the machine after each blank is stitched. In this way, *an endless chain* of cleat and sheet holders and positioners, with the material thereon, may be caused to pass between the bed-frame and stapling devices, and keep the machine working to its fullest capacity." (Italics ours.)

ing portable workholders, is found in the Miller patent No. 815,197 (R. 1549), applied for November 18, 1904, five or six months before the "draftsman" inserted into the application of the patent in suit the paragraph to which the Court of Appeals seems to have attached so much importance. There is no proof in the record that the draftsman of the patent in suit was aware (his anxiety would seem to indicate that he was) of the construction shown in the Miller patent; but, whether he was or not, the Miller patent definitely shows that the idea of chain feed, with means for holding the four cleats in position while the sheets and binding wires were being stapled into position, occurred in the art (in a machine in the hands of the man [Healy] that Inwood and Lavenberg were fighting) before the new matter was injected into the patent in suit.

It seems evident that the Court of Appeals for the Sixth Circuit was not aware of these matters when the decision was rendered, and was thus led to assigning a degree of merit to the patent in suit much greater than any to which it is entitled.

It is also possible that the Court read into the paragraph more than it really contained. The draftsman used the words "endless chain," but there was no foundation in the application for interpreting this as an endless chain in the mechanical sense; *i. e.*, a chain feed.

Obviously, no workholders constructed in any such manner as disclosed in the patent in suit could be secured together in an endless chain. In the first place, they are about as long as the flat top table itself, and such long elements could not be formed into an endless chain and caused to pass around any practical size sprocket wheel. The most favorable view which can be justified by the application itself, is to consider that the draftsman meant that one workholder could be placed in the machine

promptly after and directly following its predecessor, and thus cause them to constitute, in effect, a series of work-holders. It should also be remembered that a chain, *i. e.*, a mechanical chain, consists of a plurality of parts articulatedly connected together, and such a chain, as in Rosback, of necessity requires a guide or requires that it must operate in association with a guide. But the application for the patent in suit was applied for on the expressed theory that the object was to *dispense with guides.*

It was clearly erroneous for the Court of Appeals to assume that the draftsman, in using the language that he did, meant to imply an ordinary feed chain, such as that employed in Rosback, Greenstreet, and Lipps and Springer, and others; but even if he had, there was no "prevision" about it, for the proposition, while not justified by the patent application, was a mere recognition of the accepted practice of the time.

These matters may seem small in themselves, but they show that the Court was clearly under a misapprehension as to what the patent in suit actually taught, or was intended to teach, and was under a misapprehension as to the knowledge that was commonplace in this art at the time respondents' patentees entered the field.

Claim 25 of the Patent in Suit Is Not Covered by the Supplemental Oath.

On February 4, 1915, the applicants, Inwood and Lavenberg, by their attorney, filed a supplemental oath, together with a list of sixty-six claims, and an explanatory statement as follows:

> "Applicants present herewith a supplemental oath having annexed thereto and made a part thereof a copy of all of the claims in this application on the date of December 30, 1914.
>
> "Applicants believe that this supplemental oath is

not indispensable in the premises, but they nevertheless present the oath as a matter of protection *against any possible charge that any claim as patented is not supported by the due oath of the inventors.*" (Italics ours.) (See Petitioner's Exhibit No. 14.)

Claim 25 of the patent in suit, the single claim relied upon by the Sixth Circuit Court of Appeals to show validity and infringement of the patent, *is not found in said list of claims* (claim 25 of the list is different), and hence this claim is *not* supported by the supplemental oath.

Petitioner's Position Regarding the Significance and Effect of the Rosback Patents in This Suit.

Petitioner simply takes the position that, regardless of whether the patent in suit is valid or invalid, and regardless of how claim 25 reads, petitioner is doing only what anyone has a right to do, and therefore cannot be held to be infringing any valid claim. In support of this, petitioner points to the Rosback patents and says that the alleged infringing feature of petitioner's machines is simply the Rosback endless chain feed and stationary guides with more pushers on the chains than was apparently used in the Rosback patent. Petitioner says that merely multiplying pushers in the Rosback patents would not amount to invention, and that what could not be invention over Rosback, being public property, cannot be held to be an infringement of the patent in suit. The patent in suit may be invalid, but the Court does not need to go that far, obviously, inasmuch as petitioner's pushers and feed chains and stationary guides are structurally the same as those of Rosback, and hence there can be no infringement in merely using a greater number of pushers than Rosback used. Petitioner makes this explanation because the respondents have attempted to distort and confuse this issue by en-

deavoring to make it appear that petitioner is urging that the Rosback patents anticipate the portable workholder and guideless toothed roller stapling machine of the patent in suit. That has never been petitioner's contention, but rather that Rosback anticipates petitioner's combination of stationary guides and endless feed chains and cleat and sheet pushers, and that hence there is no infringement.

The Machine of the Patent in Suit Cannot Operate Without Stopping Between Blanks.

In the majority opinion of the Sixth Circuit Court of Appeals (R. 1803), the Court calls attention to the portion of the specification of the patent in suit quoted in the footnote at the bottom of the same page of the opinion, which includes the statement that "the carriages or formers may be fed into the machine one after the other in a manner to obviate the necessity of stopping the machine after each blank is stitched."

The machine of the patent in suit has two hand-levers 21 and 44, which must be manipulated each time a blank is made. The hand-lever 44 controls the "initial or preliminary feed to the toothed rollers 38, so as to bring the box blank in a convenient position beneath the staple drivers for the insertion of the first staples." (See lines 60 to 78, page 2 of the specification of the patent in suit.) Thereafter, "The initial feed having been made, the shipping lever 21 is pulled to rock the shaft 18, and . . . impart a partial rotation to the latter and to the toothed feed roller mounted on the shaft thereof." (See lines 18 to 70, page 3 of the specification of the patent in suit.) This shows that the machine of the patent in suit cannot run continuously without stopping between blanks, but must be stopped after each blank is finished. This is another instance of error or misunderstanding upon the part

of the Court. The Court attached importance to the paragraph it quoted, evidently not realizing that the paragraph itself was not in the original application, but was an afterthought filed about eight months after the application was filed and, furthermore, contains a positive misstatement. The Court adopts this misstatement about the ability of the machine of the patent in suit to operate without stopping between blanks, and when the Court used this statement to draw an analogy (old in Greenstreet, Lipps and Springer, and others) between the patent in suit and petitioner's machine, the Court was under a misapprehension, and the conclusion was erroneous.

The Sixth Circuit Court of Appeals Failed to Show Any Structural Difference Between Petitioner's Cleat Pushers and the Similar Pushers of the Rosback Patents.

In the majority opinion of the Court (R. 1792), the Court attempts to controvert petitioner's contention that its cleat pushers are the same as those of the Rosback patent No. 614,348, granted November 15, 1898 (R. 1406), and that, for this reason, the patent in suit cannot be construed to cover petitioner's machines, and can, at most, be construed to cover only the specific portable workholder with spacers tightly interposed between adjacent ends of the cleat. The Court holds, apparently, that petitioner's pushers are individually the same as those of the Rosback patent, but that they are greater in number, and that, for this reason, they have not only the function of pushing the cleats, but also of positioning the cleats. The Court says (Judge Knappen dissenting) that in the said Rosback patent the cleat pushers do not and cannot function as positioning devices to relatively position the cleats.

This is obviously wrong, so far as mechanics are concerned, and, in addition, unsound patent law. In

the first place, the cleat pushers of the Rosback patent *necessarily* function as positioning devices, to position the long cleats relatively to each other, for otherwise the cleats would not be properly located on the bottom of the blank. If it is not important to position the cleats in Rosback, then why did Rosback provide "hold backs," as the Court called them in petitioner's machine, to hold the cleats back against the pushers? Second, assuming that petitioner's cleat pushers operate functionally in a different manner from the pushers of Rosback, *it is obvious that the functional difference is not because of any structural difference, but simply because of the difference in the blanks;* that is to say, petitioner's blank is different from the blank of the Rosback patent.

Therefore, if the cleat pushers of petitioner's machines have any function which the cleat pushers of the Rosback patent do not have, which petitioner denies, it is clear that this is not because of any structural difference between petitioner's cleat pushers and Rosback's cleat pushers, but merely because of the difference in products,—the difference in box blanks.

Respondents' Principal Witness Very Readily Assented, on Cross-Examination, That the Spacer Block System of the Patent in Suit Is Entirely Different From Petitioner's Cleat Pusher System.

The patent in suit is not infringed, for the simple reason that the machine and method thereof and petitioner's machine and method do not operate upon the same principle. It is well settled law that one machine is not an infringement of another when it is found that they do not have the same principle, but that each involves a totally different principle, for under such circumstances a patent for one machine cannot be made to cover the

other, as no patent (no matter how its claims may read) can be lawfully expanded beyond the limits set by the principle or mode of operation of the machine disclosed in such patent. (See Robinson on Patents, Vol. I, pages 318, 236; *Dryfoos* v. *Wiese*, 124 U. S. 38.) Respondents' witness Steele, who was testifying regarding respondents' modern method of using their spacer blocks on chains, instead of on portable workholders, said:

> "X-Q. 1161. In the plaintiffs' method of manufacturing box blanks in which there are four sheets and four pairs of cleats, how many cleat pushers are there on each side of the machine?
>
> "A. Not any.
>
> "X-Q. 1162. If there are no cleat pushers, what makes the cleats go forward?
>
> "A. The cleats are carried forward in a chain and held in relative position in that chain with spacer blocks.
>
> "X-Q. 1163. Then the plaintiffs do not use cleat pushers; is that it?
>
> "A. We do not push any cleats; no, sir.
>
> "X-Q. 1164. You simply carry them along on the chains?
>
> "A. On a channel shaped chain.
>
> "X-Q. 1165. Doesn't it amount to the same thing?
>
> "(Objection here.)
>
> "A. It does not." (R. 144 and 145.)

The Effect and Meaning of the Decision of the Sixth Circuit Court of Appeals, Dismissing Two of the Patents in Suit Without Prejudice, and Finding Infringement of One Claim of the Third Patent in Suit, But Dismissing the Other Claims of This Patent Without Prejudice.

This would seem to indicate that only one invention was found. No claims for a different invention were seemingly found. Hence the one claim was apparently held by the Court to be sufficient to cover the invention involved. The majority opinion of the Court says (R. 1806):

"but even if the box patent was erroneously sustained, that error would not justify another."

The Court of Appeals for the Sixth and Seventh Circuits, therefore, are apparently in accord on the question that some invention was involved, the preforming of the cleats and the wiring of the preformed cleats together, but one Court (Seventh Circuit) has held that this inventive idea was covered in the expired reissue box patent, while the other Court (Sixth Circuit) has held that this inventive thought was covered in the machine patent in suit. The petitioner agrees with the Court of Appeals for the Seventh Circuit, which has twice held the expired reissue box patent to be valid.

The Patent in Suit Shows and Relates to a Specific Type of Portable Workholder Blank Stapling Machine That Was Never Used, and That Could Not Be Used.

The so-called guideless "bread-roller" stapling machine of the patent in suit was never used (see X-Q. 221 of the testimony of Babcock, R. 321; and the testimony of Inwood in the Healy litigation, R. 462). The machine of the patent in suit is inoperative without the guides, and the patent is invalid under the law. *No guideless machine of this kind was ever made or attempted to be used.* (This assertion has been made previously, but the proofs are here dealt with.) The only machine employing portable traveling workholders was the so-called Brown machine (see Qs. 132-138 of Babcock's testimony, R. 217; X-Qs. 168 and 169 of Babcock's testimony, R. 313; Findings 11, 28 and 42 of Master's Report in Healy litigation, R. 452 and 453; also Brown patent, R. 1611); and it is of record that not more than two or three, probably only two, of these Brown machines were ever used. But these

Brown machines did not have the "bread-roller" feed, as Inwood calls it, and, in addition, these Brown machines had guides for guiding the workholders and preventing the cleats from getting out of line with the staplers.

Conclusion.

It is evident that the Court of Appeals for the Sixth Circuit ascribed to the patent in suit a scope and validity to which it is not entitled. All of the chancellors passing upon the question, except the two who pronounced the majority opinion for the Circuit Court of Appeals for the Sixth Circuit, concurred, in substance, in the view that "the moment the long cleat was discarded and supplanted with short ones," it was obvious to anyone familiar with this industry that the blank could be produced on a machine, such as Rosback, by merely following the practice that was common in the art at the time; that is, by adding to the feed chains whatever additional pushers were necessary to correspond with the number of cleats in the blank, and by placing them in whatever position the article called for.

The Court in its majority opinion said, in so many words, that "if this statement about adding some extra pushers were correct, and were the whole truth, it would be unanswerable." The facts show that the statement is correct, and is the whole truth. If it is not the whole truth, the only thing it lacks is the positioning function of the pushers in Rosback, *on the same feed chain*. But the fact is that the pushers in Rosback *do* have a positioning function, and even if they did not, pushers of exactly the same type, for the same purpose, on the same feed chain, were well known at the time.

The Court seems to have failed to take any recognition of the fact that there were inventors other than the Ros-

back line of inventors, and that cleatless blanks having binding wires stapled to them, and requiring that the slats should be of definite spacing and width to fold even with a lap corner around the ends of the box, were well known.

It is essential, in passing upon matters of invention, for the courts to take into account the knowledge which the workers in the art possessed at the time. If this were not so, patents would be issued and sustained for every little modification or adaptation of a known machine to a slightly different use or product. This is not in accordance with the spirit or letter of the patent law, nor would it be advantageous to the public if it were so.

As this Court said, as far back as 1883, in *Atlantic Works* v. *Brady*, 107 U. S. 192, 200:

> "Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. . . . It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith."

Certainly the present litigation is vexatious, as it was started in the Spring of 1922, and a favorable adjudication to petitioner has been received from three Courts, and favorable comment from one of the chancellors in the only Court that has held the patent in suit to be valid and infringed.

If respondents had been able to show that their patentees had produced an invention of great merit and had never enjoyed the fruits thereof, there might be a temptation to disregard the facts of the case and favor the respondents. Instead of this, the Record shows that respondents enjoyed the fruits of the invention from the very beginning—1904, until the expiration of the reissue patent in 1922. They asked the courts to hold that the key to the industry resided in the reissue box patent, and the courts adopted that

view. Now, in 1930, the respondents are asking that the monopoly be extended until 1932 and that petitioner discontinue the use of a machine that has no resemblance to the disclosure in the patent in suit.

The Court of Appeals alludes to the fact that the sustaining of the patent in suit has the effect of extending the monopoly about ten years beyond the statutory seventeen-year period. Frequently, where the question of invention is close, the courts resolve the doubt in favor of the inventor, so he may have the benefit of the seventeen years contemplated by law.

In the present case, the inventors *have* enjoyed the fruits of their invention for the seventeen years. Therefore, by analogy, if the question of patentable invention were close, which we urge is not true in the instant case, the doubt, if any, should be resolved in favor of the public. Where the inventor runs a risk of receiving no reward for his invention, it may be proper for the courts to view the question in a light favorable to the inventor, but where the inventor has enjoyed the fruits of his invention for seventeen years, the equities shift, and if the question is close, it should then be resolved in favor of the public.

Respondents have pointed out that their patentees, Inwood and Lavenberg, were working on the Rosback machines at the time they made their invention, and respondents have asked why, if it was not invention to add pusher blocks to the Rosback feed chains, Inwood and Lavenberg did not do so. Petitioner has fully answered this question by showing that it was their intention to operate independently of Healy, notwithstanding their contract with him, and under the circumstances, it was most important that they should not employ anything like the Rosback ma-

chine, which was broadly covered by the patents owned by Healy. This, coupled with the facts:

(*a*) That as soon as the draftsman, or attorney, for the patent in suit had the Greenstreet patent called to his attention, he introduced a reference to the fact, if indeed that was what he meant, that chain feed could be employed.

(*b*) That Miller, patentee of Miller patent No. 815,197, within a month of the date of application for the patent in suit, showed a machine for the same kind of a blank having chain feed.

It is manifest that the Court of Appeals for the Sixth Circuit, in its majority decision, was under a serious misapprehension upon a number of points upon which it based its conclusion. No attempt will be made to give a résumé of them. There is one fact, however, which by itself would seem to be cogent reason for entitling petitioner to a decision independently of all other considerations. It is that petitioner's machine is nothing more nor less than the Rosback machine with such number of pushers added to each feed chain as may be called for by the form of the work.

It was common practice at the time respondents' patentees entered the field to employ feed chains for feeding the work in a machine for making wirebound blanks. The blanks were cleatless, but the slats were of definite width, and it was essential that the pushers or positioners on the feed chains should have a definite relationship to each other in the same feed chain in order to produce a blank which could be folded around the ends of the box. The prior art goes even further and shows the use of lugs in pairs, on the same chain, for engaging both the front and rear edge of a slat. Such lugs therefore obviously were positioners as well as pushers. In other words, in one in-

stance in the prior art (Greenstreet 579,574), the slats are definitely held by these lugs on the feed chains against any relative movement *either forward or backward*. Practically, it may be said that the feed chains had pockets in which the slats were positively held in definite spaced relation. The art even shows that by properly spacing the slats, a lap corner crate could be obtained. For convenience some of the figures of the Greenstreet drawings are reproduced at the back of this brief.

Respondents' patentees invented a box blank composed of three elements; *i. e.*, preformed cleats, preformed sheets, and binding wires stapled to the outside of the blank by staples straddling the wires and securing the parts together. A broad patent for the article was obtained, the patent as required by statute explained how the article was made, and the patent was broadly sustained by the courts. In due course, the patent expired, and the public thereupon obtained the right to make such a blank on any prior art machine with any adaptation calling only for such expedients as were well known in the industry at that time.

For reasons shown in this brief, respondents' patentees decided to, and did design a special machine for producing the product. Whether the peculiarities of design were patentable or not is outside of the proper scope of the instant suit, for the reason that petitioner does not employ any such design, but employs instead the old Rosback machine, with such pushers or lugs added to each feed chain as are called for by the increased number of cleat sections to each blank. Petitioner's position is that no matter whether it was patentable or not to devise the design of the patent in suit, there was no room for a patent for merely using the Rosback machine to produce the Inwood and Lavenberg blank. The pushers in the Rosback machine *had* to have a positioning as well as a

pushing function, but regardless of this, the idea of using lugs on the feed chains for positioning the parts of the article to be produced was well known, and it required no inventive concept—no "spark of genius" to make the changes necessary in the Rosback machine to take care of the added cleats of the Inwood and Lavenberg blank. Inwood and Lavenberg, after showing their blank, could not have obtained a patent for making that blank upon the Rosback machine with the added lugs on the feed chain. No Patent Office Examiner familiar with the art would, after having granted a patent on the box blank, have granted Inwood and Lavenberg, or anybody else, a patent for adding to the Rosback feed chains the necessary positioning and pushing lugs which were so well known on feed chains of this class of machinery at that time.

If Inwood and Lavenberg had applied for a patent on the Rosback machine at the time, with the extra pushers, the Patent Office would certainly have said: "No, we are going to give you a patent on the box blank and we can't give you a patent on Rosback with the extra lugs because all you have done is to add lugs to take care of the added cleats, and in adding the lugs, you have merely adopted what is common practice in the art."

It follows that if no patent could have been obtained for these adaptations on the Rosback machine, no patent can now be properly interpreted as having a scope sufficient to cover such a machine—and it is exactly such a machine, no more and no less, so far as the alleged infringement (cleat pushers) is concerned, that petitioner is using.

Regardless of all other considerations, therefore, petitioner should be held to be free from the charge of infringement of the patent in suit.

We submit that the Court of Appeals for the Sixth Circuit failed to take the prior art and other special circumstances of the case into due consideration, and assigned to claim 25 a virtue and validity that it did not possess.

It is submitted that claim 25 of the patent in suit should be held to be invalid, if given such scope as to include petitioner's machine.

It is further submitted that the decree of the Circuit Court of Appeals for the Sixth Circuit should be reversed on the ground of non-infringement, and the decree of the District Court for the Western District of Michigan should be affirmed.

Respectfully submitted,

HOWARD M. COX,
AMASA C. PAUL,
Counsel for Petitioner.

CHEEVER, COX & MOORE,
Solicitors.

No. 12,725. REISSUED NOV. 26, 1907.

R. G. INWOOD & P. C. LAVENBERG.

BOX.

APPLICATION FILED JUNE 13, 1907.

2 SHEETS—SHEET 1.

Fig. 1.

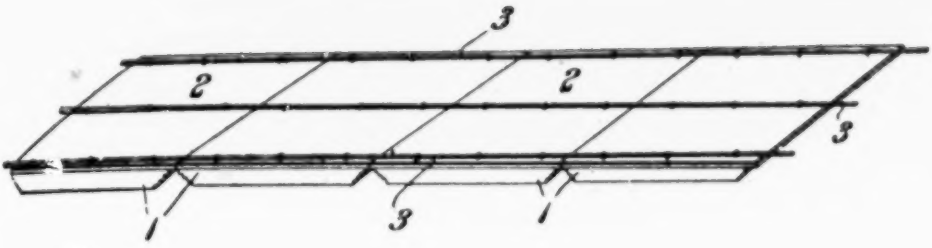
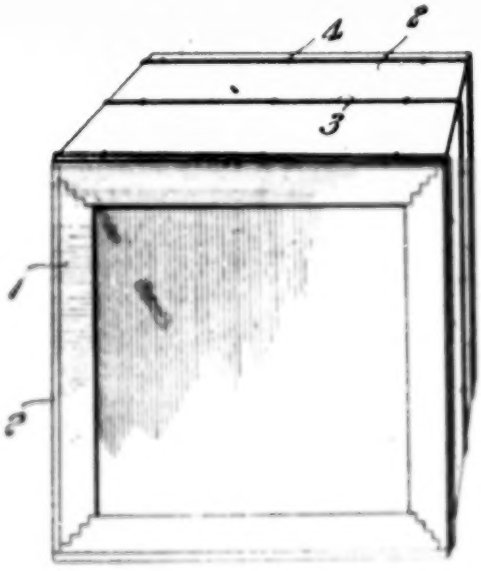


Fig. 2.



Witnesses.
E. E. Gaylord.
Geo. H. Buell.

Inventors:
Richard G. Inwood,
Percy C. Lavenberg,
By Dyer, Tuttle, Lee, Chalk & Kelly,
Attys.

No. 12,725 REISSUED NOV. 26, 1907.

R. G. INWOOD & P. C. LAVENBERG.

BOX.

APPLICATION FILED JUNE 13, 1907.

2 SHEETS—SHEET 2.

Fig. 3.

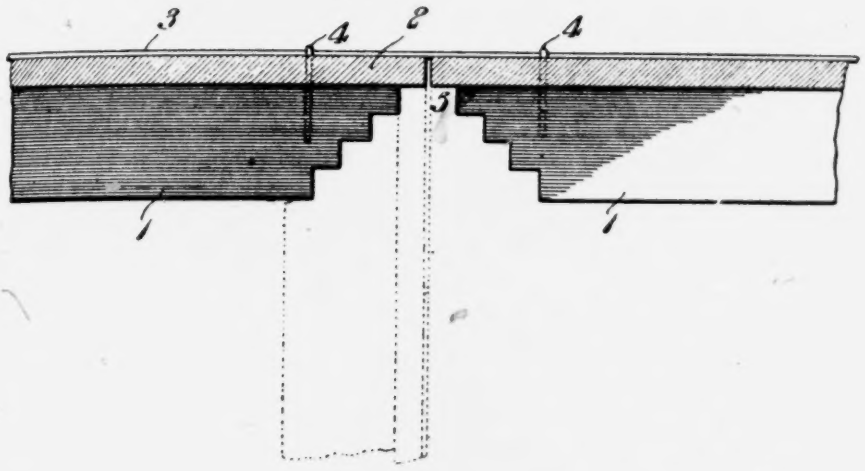
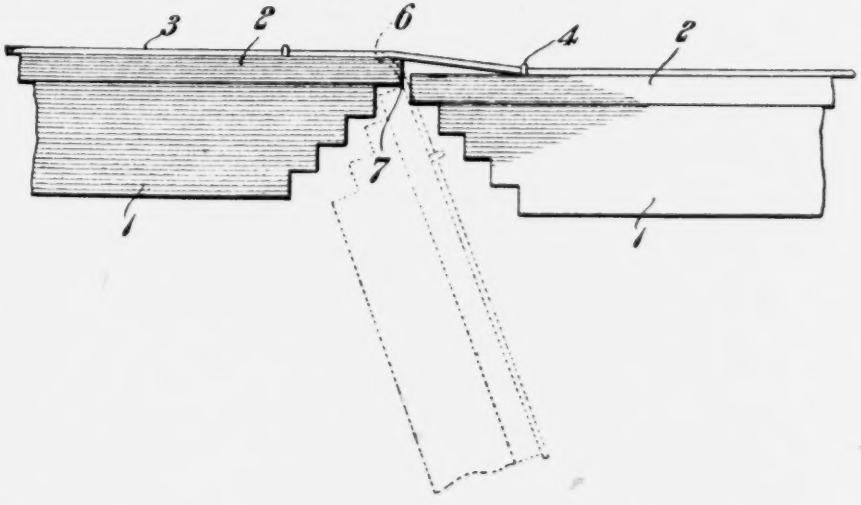


Fig. 4.



Witnesses:
Chas. E. Gaylord.
Geo. H. Buell

Inventors:
Richard G. Inwood &
Perry C. Lavenberg,
By Dyrenforth, Lee, Chritton & Wiles.

UNITED STATES PATENT OFFICE.

RICHARD G. INWOOD AND PERRY C. LAVENBERG, OF SOUTH BEND, INDIANA, ASSIGNORS TO THE NATIONAL WIRE BOUND BOX COMPANY, OF SOUTH BEND, INDIANA, A CORPORATION OF INDIANA.

BOX.

No. 12,725. Specification of Reissued Letters Patent. Reissued Nov. 26, 1907.

Original No. 799,554, dated September 19, 1905. Serial No. 228,765. Application for reissue filed June 13, 1907. Serial No. 378,881.

To all whom it may concern:

Be it known that we, RICHARD G. INWOOD and PERRY C. LAVENBERG, both citizens of the United States, residing at South Bend, in the county of St. Joseph and State of Indiana, have invented a new and useful Improvement in Boxes, of which the following is a specification.

Our invention relates to certain improvements in wire bound boxes, especially of that class in which the blanks constituting the four sides of the box are assembled and secured in relative position to each other prior to folding by reinforcing wires, and has for its object the assembling and fastening together such parts constituting the completed blank so that the same when folded will produce overlapping edges of the side sheets or boards, the advantages of which will be hereafter pointed out.

Referring to the drawings:- Figure 1 shows a complete box blank which forms the four sides of a box when folded. Fig. 2 is a perspective view of the blank when folded showing the sides thereof overlapping and box end in place. Fig. 3 shows two enlarged sections of the blank the full lines before folding and the dotted lines a section folded at right angles to the other in making a joint, the full lines also showing the spacing of the cleats and sheets with relation to each other. Fig. 4 shows an enlarged fragmental view of two sections, and the radius of movement relative to each other at different stages in the action of folding.

In the drawings 1 are the cleats which are step-mitered at their ends.

2 are the box sides or sheets which are disposed upon the cleats, and 3 are reinforcing wires which are positioned coincident with the cleats and staples 4 driven straddling of said wires through the sheets into the cleats, the reinforcing wires thereby also serving to hinge the four sections comprising the completed blank together.

The ends of the cleats 1 are spaced a distance apart measured from the adjoining edges of the sheets, equal to the thickness of such sheets, as at 5 so when the blank is folded to form the four sides of a box, the sheets will overlap, and form a square cornered box, as shown in Fig. 2.

It may appear from the drawing that difficulty would be experienced in folding the sections owing to the edges of the sheets abutting, and the same being held in that relative position and against movement away from each other by the reinforcing wires. It is found in practice, however, the sheets being of soft wood veneering, that in folding over one section on the other, the reinforcing wire will cut into the sharp edges of the sheets, as shown at 6 in Fig. 4, and the end of one sheet will crush the inner edge of the adjoining sheet sufficiently, as at 7 Fig. 4, so as to allow same to pass each other, and fold over so as to form overlapping edges or joints.

The present method of manufacturing wire-bound boxes is to form the blank of a single sheet stitched or stapled to single piece cleats for each end of the box, the cleats being stepmitered and the sheets scored or grooved on the under side, so as to form four sections, after the cleats, sheets and reinforcing wires have been stapled together. This box blank when folded forms a rounding edge, the veneer sheets if not thoroughly seasoned so as to have pliability, begin to check as the lumber seasons. As the grain of the wood may be diagonal to the edge of the box, the check will follow the grain, thus rendering the box unsightly, besides a possible opening of a size so as to preclude its use for goods requiring a tight jointed box.

We claim as our invention, and desire to secure by Letters Patent —

1. A wire-bound foldable box-blank, comprising a plurality of straight-edged sheets, wires secured to and connecting said sheets, and cleats secured to said sheets to terminate short of edges of the latter a distance equal or approximately equal to the thickness of a sheet, whereby when folded at a right-angle the end of one sheet overlaps the end of an adjacent sheet.

2. A wire bound foldable box blank, comprising a plurality of straight edged sheets, wires secured to and connecting said sheets, and step-mitered cleats secured to said sheets to terminate short of edges of the latter a distance equal to the thickness of a sheet, whereby when folded at a right angle the end of one sheet overlaps the end of an adjacent sheet.

RICHARD G. INWOOD
P. C. LAVENBERG.

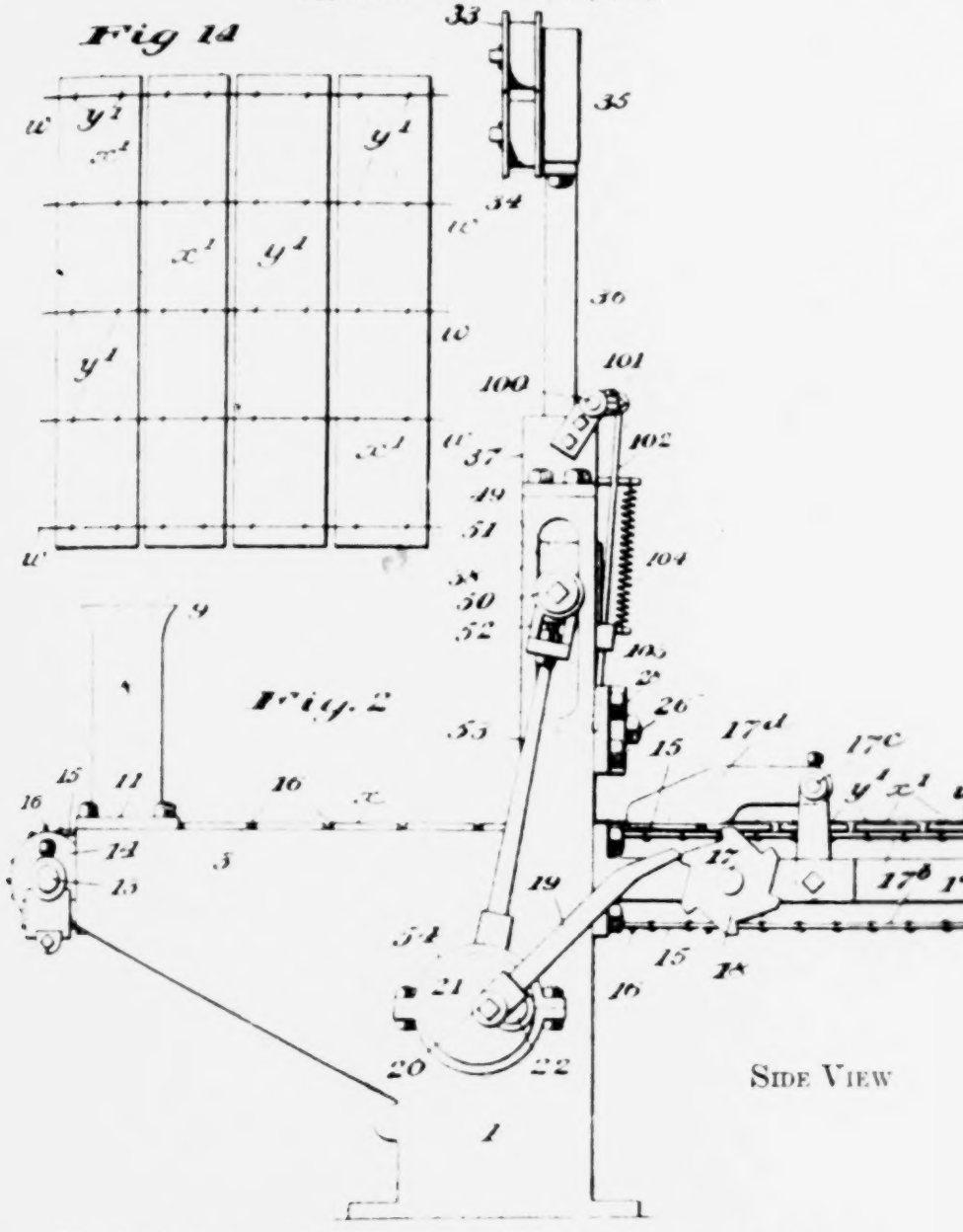
Witnesses:
BLANCHE RESSLER,
J. E. WHITEHALL.

No. 801,998. Patented Oct. 17. 1905.

W. LIPPS & I. SPRINGER.

Box Making Machine.

Application Filed June 30, 1902.



The feed chains 15 are each provided with a series of lugs 16 for feeding the slats x to the stapler head for the stapling of the binding wires w. These lugs 16 are not only pushers but are also positioners of the slats and keep them in definite spaced relation with each other.

No. 801,998. Patented Oct. 17. 1905.

W. LIPPS & I. SPRINGER.

Box Making Machine.

Application Filed June 30, 1902.

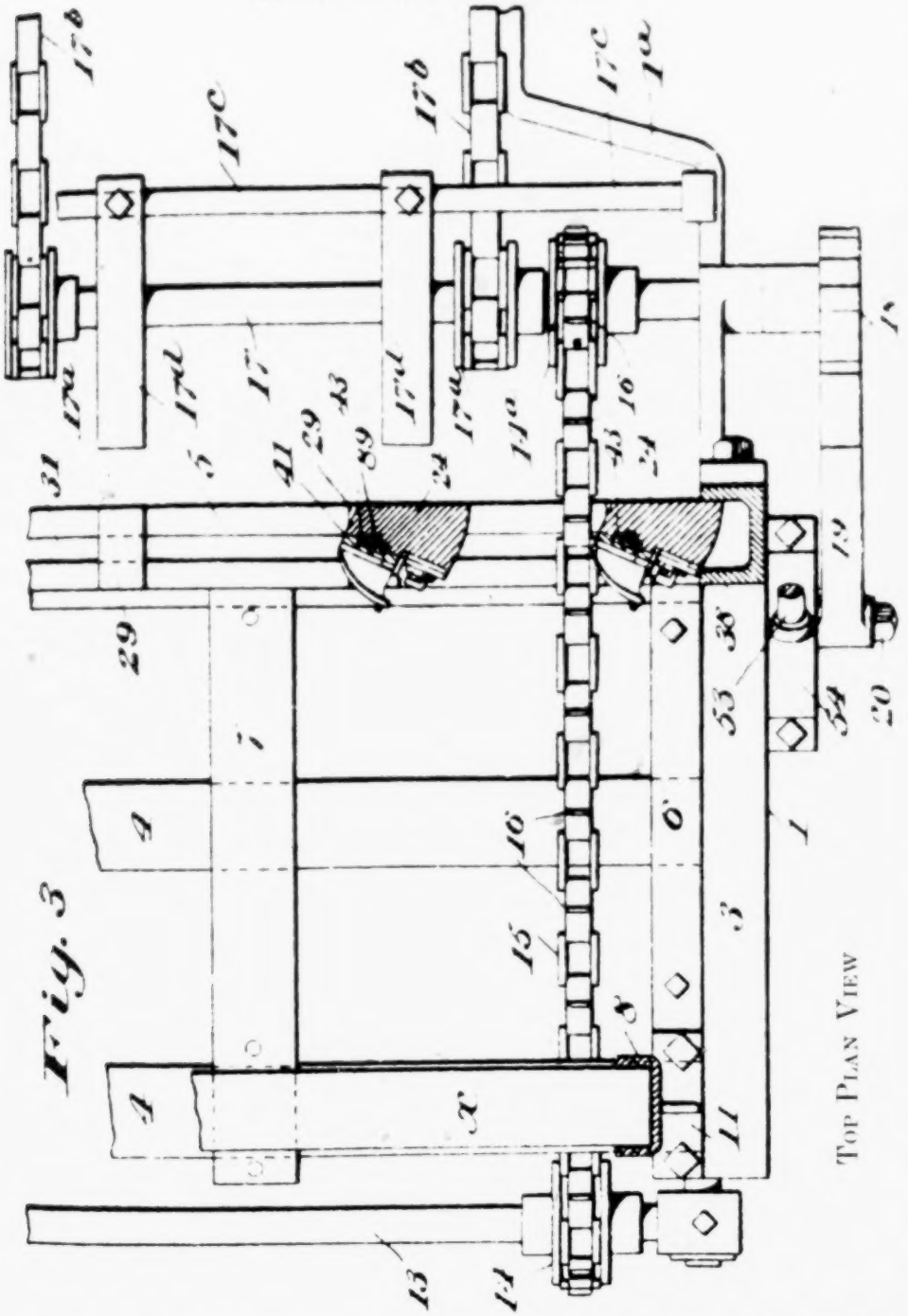


Fig. 3

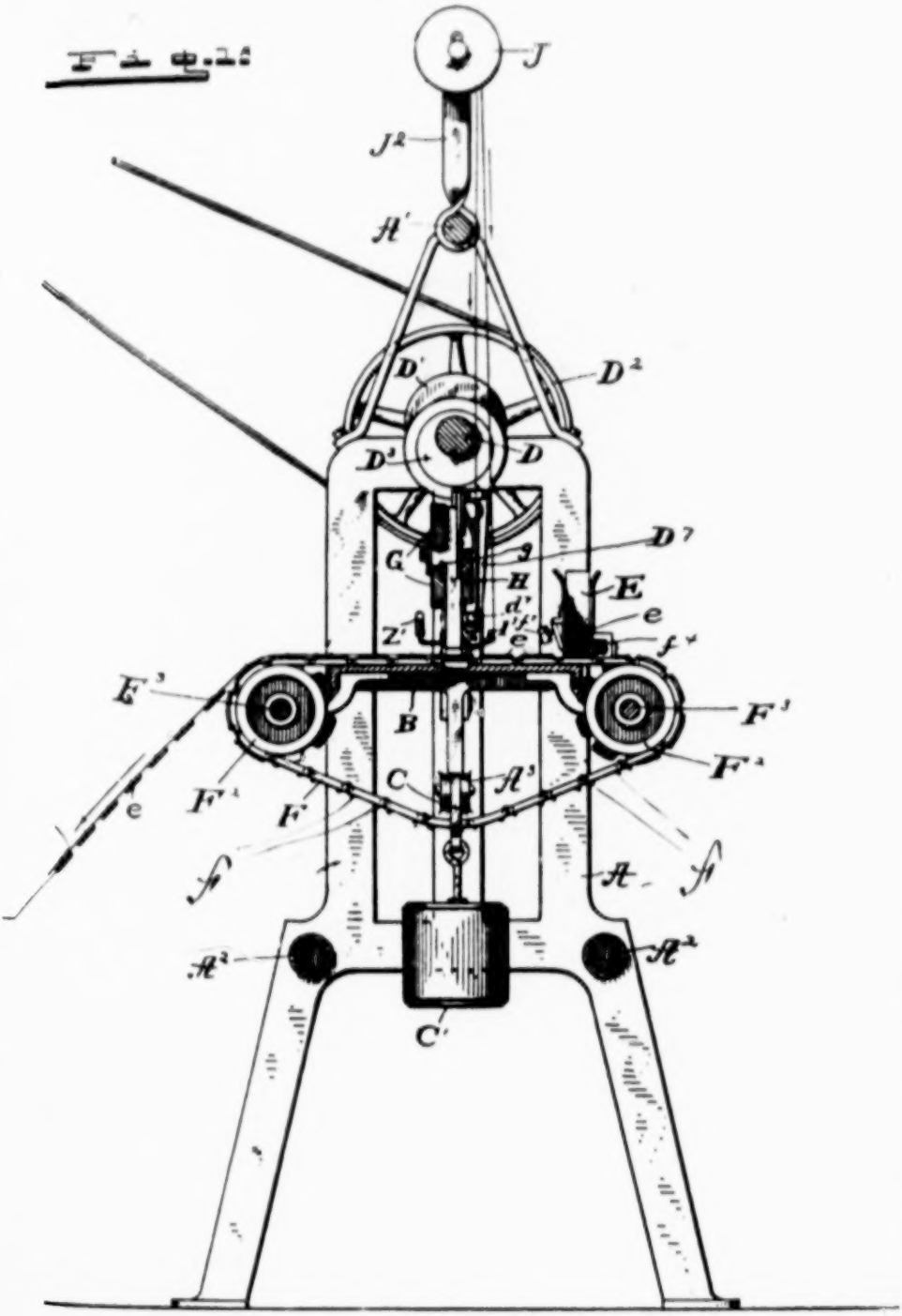
The feed chains 15 are each provided with a series of lugs 16 for feeding the slats *x* to the stapler head for the stapling of the binding wires *w*. These lugs 16 are not only pushers but are also positioners of the slats and keep them in definite spaced relation with each other.

(No Model.) 3 Sheets—Sheet 2

J. H. GREENSTREET.

BOX MAKING MACHINE.

No. 579,574. Patented Mar. 30, 1897.

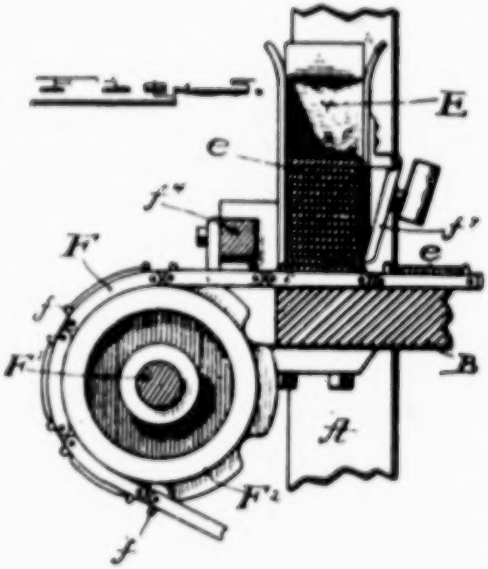


The outward projections, or pushers f, on the feed chains occur in pairs; one of each pair engages the rear edge of the slat to push it forward and correctly position it, and the other engages the forward edge to prevent the slat from moving out of position in a forward direction. Thus, this patent shows the use of projections, or pushers, for both the front and rear edge of each slat, and they serve both as pushers and as positioners for insuring that the slats shall be accurately spaced from each other.

J. H. GREENSTREET.

Box Making Machine.

No. 579,574. Patented Mar. 30, 1897.



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